
United States Court of Appeals

FOR THE NINTH CIRCUIT.

HARRY X. BERGMAN, PERMA-LOX ALUMINUM SHINGLE CORPORATION and VICTOR H. LANGVILLE, doing business under the assumed name of LANGVILLE MANUFACTURING COMPANY,

Appellants,

vs.

ALUMINUM LOCK SHINGLE CORPORATION
OF AMERICA,

Appellee.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON.

BRIEF OF APPELLEE.

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INDEX.

I. STATEMENT OF THE CASE	1
A. Weakness of Anticipation of Korter Shown by Shifting Grounds of Defendants	3
II. THE PROBLEM SOLVED BY THE INVENTION OF THE PATENT IN SUIT	4
III. THE KORTER PATENT CLAIM RECITES SIX MAIN FEATURES IN COMBINATION, ALL COOPERATING TO PRODUCE A UNITARY RESULT OF SURPRISING CHARACTER	5
IV. DEFENDANTS INFRINGE THE KORTER PATENT.....	7
A. General Discussion	7
(1) Korter is entitled to a reasonable range of equivalents in regard to the position, shape and size of the drain slot as an ele- ment of the entire claimed combination...	12
(2) The drain slot in the accused shingle cooperates with the other elements of that shingle in the same manner as the drain slot cooperates with the other ele- ments of Korter's combination claim...	16
B. All of the important elements and functions of the Korter patent claim are found in the Bergman shingle	16
(1) Transcript record proving infringement	16
(2) Bergman could show no material differ- ence in the court below or in his pre-trial deposition between his shingle and the Korter claim	17
C. Defendants' Case, to Avoid Infringement Ap- pears to Be Built up on Alleged File Wrapper Estoppel—at Best a Flimsy Excuse	18

(1) No limitation on the breadth of the patent claim is caused by	
(a) The suspension of the prosecution of Korter's earlier application Serial No. 776,332 (PX 28)	18
(b) By the cancellation of claim 10 or any other claim in the patent file...	23
(c) There are no intervening rights in favor of defendants	26
V. KORTER PATENT IS BELIEVED TO BE VALID	28
A. Korter's Contribution of a Lifetime Shingle Made of a Non-Rustable, Ordinarily Non-Oxidizable Metal, Aluminum, to Supplant Hard to Manufacture Slate Shingles and Short-Life Wood and Tile, Filled a Long-Felt Want	28
B. Korter's Claim Contains Ten Features All Cooperating Together to Produce a New and Unobvious Result of Getting Rid of Moisture Condensate From the Inner Side of a Metal Shingle	30
C. Korter's Claim is Believed to Be Valid Over the Miller Patent Considered Either Separately or in Connection With Birch et al.	32
(1) Miller is indefinite, inaccurate and therefore violates the rule that any patent, alleged to anticipate, must be clear, precise and definite	32
(2) Miller does not disclose all of the ten features of the Korter combination claim—it lacks at least five important features...	34
(3) Miller is not concerned with the problem that Korter solved, namely the elimination of moisture condensate moving slowly in the vertical direction but	

along the entire length and width of each shingle. Therefore, Miller cannot show apparatus by which the problem could be solved	37
(4) The transcript record shows that Miller cannot anticipate the Korter claim.....	40
(5) The argument set forth in appellants' brief, pages 44 to 47, as to the alleged pertinency of Miller is spurious	40
(6) Korter's combination claim was specifically allowed over Miller by the Patent Office. The burden of proving the patent claim invalid is on appellants—have not sustained burden	44
D. The Birch et al. Patent Which Appellants Attempt to Combine With Miller (Bottom of Page 45 of Their Brief) Like Miller, Does Not Consider the Problem of the Elimination of Moisture Condensate on the Interior of the Shingle—Birch Cannot Anticipate	45
(1) The Birch patent was withdrawn by the defendants at the pre-trial conference (Tr. 35) and is not strictly involved in the appeal	45
(2) However, without relinquishing the point that Birch has been disclaimed by defendants as a reference and is not part of this appeal, perhaps out of an abundance of caution, appellee wishes to point out that even if Birch were part of the Record, it still would not anticipate the Korter claim, considered either separately or in combination with Miller	46
(3) There is no identity of disclosure between the Miller and Birch patents as would justify combining them—the purposes of the patents are entirely different	46

(4) Appellants' argument (page 48 of their brief) as to why Miller and Birch should be combined, how to combine, and what would be the result of combining, is both incomplete and not convincing	48
E. Slaughter Patent Is Not Pertinent	49
(1) Slaughter fails to show the ten features of Korter's combination claim	49
(2) Slaughter does not mention or suggest problem of getting rid of moisture condensate—the shingle could not inherently take care of the condensate	50
(3) Transcript reference to this patent.....	50
(4) Description of function of Slaughter structure as given on page 48 of appellants' brief, is completely in error.....	51
F. Cusack Patent Utterly Irrelevant	52
(1) All of the features covered by Korter's combination claim are lacking in the patent	52
(2) Diamond shaped shingle—not laid rectangular—no spacing between wooden sheathing and shingle—no moisture condensate problem to solve	52
(3) Appellants' description of this patent given on page 48 of their brief completely in error and misleading—not in accord with the record on appeal	52
G. Crawford Does Not Anticipate and Was Discredited Even by Defendants	53
(1) "All the folded edges fastened together are hammered down so as to be substantially flat and perfectly water-proof"	

(Col. 2, line 98)—lacks all the features of Korter's combination claim	53
(2) No mention or suggestion of moisture condensate problem which Korter solved—Crawford shingle presents no way of getting rid of the moisture	53
(3) Record below shows that demonstration of Crawford shingle put on by defendants was not in accordance with Crawford disclosure	54
(4) Description of Crawford shingle given in appellants' brief on page 48 is incorrect	54
(5) Defendants have discredited the Crawford patent—hence cannot anticipate....	54
H. Lewando Patents	55
(1) Diamond shaped shingle—not laid rectangularly—lacks all the elements of Korter's combination claim	55
(2) No mention of Korter's problem of eliminating water condensate, could not get rid of water as all joints "filled with cement"	55
(3) Appellants' description given on page 48 completely in error and misleading.....	56
(4) Transcript record below shows that neither of the Lewando patents can anticipate	56
I. Clawson Patent	57
(1) No evidence was offered by defendants in the court below as to this patent—therefore cannot be seriously viewed from anticipation standpoint	57
(2) Lacks at least one-half of the ten features in Korter's patented combination.....	57

(3) Shows a diamond-shaped shingle—not laid rectangularly—not concerned with Korter's problem of eliminating moisture condensate along a horizontal gutter_____	57
(4) Description given in appellants' brief on page 48 is in error and not supported by any evidence _____	58
J. British Patent de Sincay _____	59
(1) Diamond-shaped tile—not laid rectangularly—patent lacks many of the ten features of the Korter claim _____	59
(2) Not concerned with moisture condensate removal along a horizontal gutter—record below shows that one-half of the shingles lay perfectly flat on the roof so that no drainage of moisture can take place _____	60
(3) Description given in appellants' brief, top of page 48, as to alleged flow of moisture condensate is in error and not in accord with the patent disclosure or record below _____	60
VI. BERGMAN IS PERSONALLY LIABLE FOR INFRINGEMENT _____	62
A. Defendants' Cases Distinguished _____	70
VII. CONCLUSION _____	72
APPENDIX OF DECISIONS _____	1a

TABLE OF AUTHORITIES.

Cases.

<i>Adventures in Good Eating v. Best Places to Eat</i> , 131 F. 2d 809 (7th Cir.)	66, 71
<i>Alliance Securities Co. v. J. A. Mohr & Son</i> , 14 F. (2) 793 (N. D. Calif., S. D) affirmed 14 F. (2) 799 (C. C. A. 9)	61
<i>Anraku v. General Electric Co.</i> , 80 F. (2) 958 (C. C. A. 9)	26, 8a
<i>Baltzley et al. v. Spengler Loomis Mfg. Co. et al.</i> , 262 Fed. 423 (C. C. A. 2)	26, 5a
<i>Bullock Electric Mfg. Co. et al. v. Crocker-Wheeler Co.</i> , 141 Fed. 101 (Circuit Court, D. New Jersey)	26, 6a
<i>Campbell Metal Window Corporation v. S. H. Pom- erooy & Co.</i> , 300 Fed. 872	23, 25, 27, 4a
<i>Celanese Corporation of America v. Essley Shirt Co., Inc.</i> , 98 F. (2) 895 (C. C. A. 2)	26
<i>Claude Neon Electrical Products, Inc. v. Brilliant Tube Sign Co. et al.</i> (C. C. A. 9), 48 F. (2) 176	29
<i>Claude Neon Lights, Inc. v. American Neon Light Corporation</i> , 39 F. 2d 548 (2nd Cir.)	68
<i>Coffin v. Ogden</i> , 18 Wall. 120, 21 L. Ed. 821	40, 8a
<i>Collins, Ex parte</i> , 44 USPQ 82	26, 6a
<i>Dangler v. Imperial Machine Co.</i> , 11 F. 2d 945 (7th Cir.)	70, 71
<i>D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.</i> , 259 Fed. 236 (6th Cir.)	71
<i>Dean Rubber Mfg. Co. et al. v. Killian</i> , 106 F. (2) 316 (C. C. A. 8)	22, 24, 26, 45, 66, 5a, 13a

<i>Electrical Products Corporation v. Neale</i> , 48 F. 2d 824 (D. Ct., S. D. Cal., Central Div.)	68
<i>Ensign Carburetor Co. v. Zenith-Detroit Corporation</i> , 35 F. (2) 684 (C. C. A. 2)	26, 7a
<i>Frick Co. v. Lindsay</i> , 27 F. (2d) 59 (C. C. A. 4) 1928	15
<i>General Electric Corporation v. Hygrade Sylvania Corporation et al.</i> , 67 USPQ 72	26, 7a
<i>General Motors Corporation v. Kesling</i> , 164 F. (2) 824 (C. C. A. 8)	16, 3a
<i>General Motors Corporation v. Provus</i> , 100 F. (2) 562 (C. C. A. 7)	68, 13a
<i>Gere v. Canal Boiler Works</i> , 33 F. Supp. 558 (D. C., W. D. Wash. N. D.)	68, 14a
<i>Goodwin Film & Camera Co. v. Eastman Kodak Co.</i> (District Court, W. D. N. Y.) 207 Fed. 351	21, 5a
<i>Gordon Form Lathe Co. v. Walcott Machine Co.</i> , 32 F. (2) 55	40, 9a
<i>Hoeltke v. C. M. Kemp Mfg. Co.</i> , 80 F. (2) 912 (C. C. A. 4)	45, 9a
<i>Hydraulic Press Mfg. Co. v. Ralph N. Brodie Co. et al.</i> , (District Court, N. D. California, S. D.), 51 F. Supp. 202, 59 USPQ 268, affirmed 151 F. (2) 91 (C. C. A. 9)	44, 9a, 10a
<i>Imhaeuser v. Buerk</i> , 101 U. S. 647	47, 12a
<i>Kendall v. Trico Products Corporation</i> , 31 F. (2) 522 (C. C. A. 6)	29
<i>Krieger v. Colby</i> , 106 F. Supp. 124 (Cal.)	69
<i>Lombard et al. v. Coe</i> , 33 F. Supp. 440 (District Court, District of Columbia)	47, 12a
<i>Loom Co. v. Higgins</i> , 105 U. S. 580	40, 8a
<i>Lyon v. Bausch & Lomb Optical Co.</i> , 119 F. Supp. 42 (District Court, W. D. New York)	26

<i>Lyon v. Bausch Lomb Optical Co.</i> , 224 F. (2) 530 (C. C. A. 2) -----	29
<i>Marks v. Polaroid Corporation</i> , 129 F. Supp. 243 (U. S. Dist. Ct., D. Mass.) -----	67
<i>Martin v. Be-Ge Mfg. Co. et al.</i> , 109 U. S. P. Q. 240 (C. C. A. 9—decided April 19, 1956) -----	63
<i>Moseley v. United States Appliance Corporation</i> , 155 F. 2d 25 (C. C. A. 9) -----	65
<i>Myers v. Beall Pipe & Tank Corporation</i> , 90 F. Supp. 265 -----	11
<i>Myers, F. E., & Bro. Company v. Goulds Pumps, Inc.</i> , 86 USPQ 12 (District Court, W. D. New York) --	26
<i>National Tube v. Mark, et al.</i> , 216 F. 507 (C. C. A. 6)	25
<i>N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.</i> , 25 F. (2d) 659 (C. C. A. 6) -----	40, 47, 8a
<i>Pacific Contact Laboratories, Inc. et al. v. Solex Labo- ratories, Inc.</i> , 209 F. (2) 529 (C. C. A. 9)-----	29
<i>Powder Power Tool Corporation v. Powder Actuated Tool Company</i> , 230 F. 2d 409 (7th Cir.) -----	70
<i>Sanitary Refrigerator Company v. Winters, et al.</i> , 280 U. S. 30 -----	8, 3a
<i>Schmeitz Wire Glass Co. v. Western Glass Co.</i> , 178 F. 977 (Circuit Court N. D. Ill. E. D.) -----	33
<i>Skelton v. Baldwin Tool Works</i> , 58 F. (2d) 221 (C. C. A. 4) 1932 -----	15
<i>Smith v. Goodyear Dental Vulcanite Co.</i> , 93 U. S. 486	21
<i>Southwestern Tool Co. v. Hughes Tool Co.</i> , 98 F. 2d 42 (10th Cir.) -----	66
<i>Specialty Equipment & Machinery Corp. v. Zell Motor Car Co.</i> , 193 F. (2) 515 (C. C. A. 4)-----	11, 1a
<i>Tinsel Corporation v. B. Haupt & Co.</i> , 25 F. 2d 318--	71

<i>Topliff v. Topliff</i> , 145 U. S. 156	39
<i>United States Rubber Co. v. General Tire & Rubber Co.</i> , 128 F. (2) 104 (C. C. A. 6)	11, 1a
<i>Ward, Frank E., Ex parte</i> , 35 USPQ 538.....	47, 48, 12a
<i>Westinghouse Electric & Mfg. Co. v. Condit Electrical Mfg. Co.</i> , 194 Fed. 427	23, 4a

Texts.

<i>Amdur, Patent Office Rules and Practice</i> , Sec. 199c...	26, 7a
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69 C. J. S., Patents, 918, Sec. 315	69, 14a
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35 U. S. C. A. 253	20
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No. 14,968.

United States Court of Appeals

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HARRY X. BERGMAN, PERMA-LOX ALUMINUM SHINGLE CORPORATION and VICTOR H. LANGVILLE, doing business under the assumed name of LANGVILLE MANUFACTURING COMPANY,

Appellants,

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APPEAL FROM THE UNITED STATES DISTRICT COURT
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BRIEF OF APPELLEE.

Since appellants' "Statement of the Case" includes considerable controversial matter, going far beyond a mere statement of the issues involved, it becomes necessary for appellee to give his own statement under the rules.

I. STATEMENT OF THE CASE.

The appellee (Aluminum Lock Shingle Corporation of America) brought this action against Harry X. Bergman, Perma-Lox Aluminum Shingle Corporation, and Victor H. Langville, doing business under the assumed name of Langville Manufacturing Company, for infringement of

the Korter patent No. 2,631,552 (PX 1*). The patent is for "Aluminum Shingle" and the single claim is relied on as being infringed. The complaint also charged unfair competition and prayed for a permanent injunction and a decree enjoining defendants, and each of them, from competing unfairly with plaintiff, and for recovery of general and special damages due to the wilfulness of the infringement, also for recovery of costs and attorneys' fees.

The defendants have denied the charges, contending that the patent claim is not valid and is not infringed, and also counterclaimed for unfair competition.

By Pre-trial Order (Tr. 35), Judge Fee directed that the unfair competition charges by both parties be held in abeyance until the final determination of the validity and infringement issues. Certain exhibits including prior art patents, explanatory charts, samples of shingles and contentions were offered by the parties and became a part of the trial record and were stipulated into the record of appeal.

At the trial, all of the parties testified on their own behalf and, in addition, Max Richardson, a patent agent of Portland, served as an expert witness for party Korter. Victor H. Langville, one of the defendants, served as an expert witness in his own behalf.

A demonstration (simulating the effect of water condensate) was put on in the courtroom by party Korter to show the similarity of the Korter and Bergman shingles, and party Bergman put on a demonstration in an attempt to show the similarity between the Korter shingle and the

* PX is used to designate Plaintiff's Exhibit; DX is used to indicate Defendants' Exhibit; Tr. indicates page of transcript of the appeal record; emphasis in the decisions added unless otherwise indicated.

Crawford patent. No other physical demonstrations were made.

The trial court found in favor of Korter (appellee) as to both issues of validity and infringement, granting a permanent injunction and an accounting against each of the defendants, separately and collectively. The taxation of costs and attorneys' fees were deferred until entry of the final decree upon the remaining issues (unfair competition) to be disposed of.

A. Weakness of Anticipation of Korter Shown by Shifting Grounds of Defendants.

Perhaps the most unusual aspect of this case is the wholesale manner in which defendants have shifted their grounds or emphasis in trying to anticipate Korter's claim, both before the trial court and then, again, before this Honorable Court. Of the ten patents advanced by defendants in the Pre-trial Order only four, namely Miller, Crawford, Belding and Pruden, were discussed by defendants' witnesses. The other six, namely the two Lewando patents, Slaughter, Cusack, Clawson, and British de Sincay, on which defendants now seem to rely, at least in part, were completely neglected by them in the court below.

Defendants placed most of their emphasis at the trial on Crawford, even to the extent of running a courtroom demonstration on shingles which they said were made in accordance with Crawford.

However, in their appeal brief, they seem to have relegated Crawford to a minor position (mentioned only on page 48 as part of a group of patents) in the anticipation scale, emphasis now being shifted to the Miller and Birch patents in combination. However, Birch was,

in effect, *withdrawn* from the case by the defendants in having excluded this patent from the Pre-trial Order.

This shift in ground has made it difficult for appellee to appraise the patents on which appellants now rely, in the absence of having had the opportunity of bringing out the inherent weakness of such patents by cross-examination.

II. THE PROBLEM SOLVED BY THE INVENTION OF THE PATENT IN SUIT.

Prior to the introduction of the Korter application that was filed September 26, 1947 (Serial No. 776,332) and its co-pending application Serial No. 137,566, filed January 9, 1950, which resulted in the patent in suit, there was no commercially successful aluminum roof which embodied all of the features of the Korter shingle. The prior art cited by the defendants will be considered separately, but at this time we wish to point out that none of the patents specifically mention the use of an *aluminum* shingle, to which Korter's invention is addressed (Tr. 85). Aluminum is not an ordinary metal such as zinc mentioned by de Sincay or copper suggested by Miller (Tr. 194), both of which can be soldered, but aluminum has been a long-sought-after metal for shingles on account of its light weight but never attained due to practical difficulties of manufacture and installing, prior to Korter (Tr. 254).

Korter's entire purpose was to provide a shingle, made of aluminum, which sets above new sheathing or the old shingles, to leave an air space, and get rid of the inevitable water of condensation over the entire length and width of the shingle within that space and still use a water-tight interlocking joint along the upper and lower horizontal edges.

The improvement patent in issue differs from Korter's earlier application, of which the patent is a continuation, in that a drain slot of large size has been provided in a protected position at one end of the channel and always remains open, without clogging, even with dust or sand in the air.

III. THE KORTER PATENT CLAIM RECITES SIX MAIN FEATURES IN COMBINATION, ALL COOPERATING TO PRODUCE A UNITARY RESULT OF SURPRISING CHARACTER.

The six important features are set forth immediately below and the surprising result is that none of the moisture of condensation which slowly runs as trickles or sweat beads from the top horizontal edge of the shingle to the lower horizontal edge and over the entire length of the inner surface of the shingle drops to the wood sheathing below or to the plaster, in case there is no sheathing.

Would it not be surprising to observe, on a cold but sunshiny day, water being emitted from the lower side of the Korter shingle and running down the weather side of the lower adjacent shingle to reach the roof gutter? This water of condensation is formed solely due to difference in temperature between the external and internal surfaces of the shingle (Tr. 91) and *has nothing to do with rain water.*

The main elements of the claim are:

1. The corrugations or ridges 12 shown in Figs. 2, 4 and 6, which corrugations have been set forth in the claim as "forming ridges on the inner face of the shingle," meaning that the corrugations extend downwardly from the inner face of the shingle.

2. The spacing between the inner face of the shingle and the upper surface of the scroll of the next lower ad-

jacent shingle. This spacing can be seen in Figure 4 of the patent and is brought about by the fact that the corrugations or feet which are integral with the upper shingle contact the upper surface of the curved end 19, and thereby prevents this upper surface from contacting the inner surface of the upper shingle. The space between these ridges or feet constitute channels for the water of condensation to flow into the interlocking joint.

3. The "top and bottom turned-in edge portions comprising a half round portion." This refers to the portions indicated at 20 and 19, Figure 4 of the patent. The upper shingle is tangent to the upper edge of the half round portion 20 so as to give a full depth of gutter at this position.

4. The fastening tab—element 15 (Figures 1 and 2).

5. The gutter—as explained hereinbefore, is formed by the full half round portion 20 which constitutes a tangential extension of the lower part of the shingle and thus gives ample room for the water to run along the lower edge of the shingle.

6. The drain slot—element 21 of the Korter patent and, while it has been shown in the drawing as having an elliptical shape, the claim makes no requirements or limitations of shape or position of the slot except that "it shall be disposed in the gutter of the shingle."

The purpose of these six elements all cooperating together has been set forth in the object of the invention, column 1, par. 2, of the patent and is repeated in the last seven lines of the claim which read: "said corrugation ridges on the inner face of the shingle adapted to space said reversely turned top edge portion of the lower adjacent shingle from the inner face of said shingle so that moisture can travel along the inner face of the shingle and into said gutter."

This function of conducting the water condensate from the inner surface of the shingle through a tightly fitted interlocking joint which allows no water in the opposite direction could not be performed if the "corrugation" element of the claim is missing; nor could it be performed if the feature of having a spacing between the inner surface of the shingle and the upper surface of the scroll of the next lower adjacent shingle were missing, nor would it be efficiently performed if the top and bottom turned-in edge portions were not of a half-round character to give a full and complete gutter.

Nor would this function be performed if the gutter recited by the claim were missing, or if the recited drain slot or its equivalent were not present. In other words, every one of the six elements listed hereinbefore must necessarily be present in the combination, each performing its own sub-function in order that the main function of getting rid of the water condensation can be performed.

IV. DEFENDANTS INFRINGE THE KORTER PATENT.

A. General Discussion.

The accused shingle (PX 3) performs the same result in substantially the same manner as plaintiff's shingle (PX 2) because in both cases condensation water which forms over the entire length and width of the interior surface of each shingle would slowly flow down the shingle in driblets past the interlocking joint through spaces constituted as channels between downwardly extending ridges and into a semi-circular gutter, and, finally, out through a drain opening at the end or substantially at the end of the gutter.

In other words, both shingles are so constructed and arranged as to get rid of the water of condensation and

both shingles are intended to be elevated along one of its long lengths above the old roof or the new sheathing, which provides the wedge-like chambers and the air contained therein gives rise to the water of condensation when the temperature is suddenly decreased. The principle of the Korter invention and the manner of operation of the accused shingle are shown in a diagram "Principles of Korter's Invention" (PX 5). *Sanitary Refrigerator Company v. Winters, et al.*, 280 U. S. 30, 42 (appendix, p. 3a).

This principle was illustrated in connection with a section of roof made with plaintiff's shingles (PX 13) as compared with a section of roof made with defendant's shingles (PX 14). The water of condensation was simulated by the use of a spray gun which applied a film of water to the inside surface of each of the roof sections. Richardson explained the object of the demonstration on Tr. 108. His testimony stands un rebutted.

The similarity between the Korter shingle and the accused shingle is further brought out by photographs A to D, in which A and B show respectively the outside and the inside surfaces of the *Korter* shingle, and C and D show respectively the outside and the inside surfaces of the *accused* shingle. These photographs were taken from the official exhibits (PX 2 and PX 3) which were loaned to counsel by stipulation. The legends have since been added.

T
R

R SIDE
H INGLE



GUTT
FOR C
DENS
MOI ST

A.

INVERTED
CORRUGATION
OR INVERTED
RIDGE

UNDERSIDE
OF SHINGLE

SHINGLE

B.



NOTE-WIDE
EASILY ACCESSIBLE
SPACE BROUGHT ABOUT
BY THE INVERTED
CORRUGATIONS FOR
MOISTURE TO RUN INTO

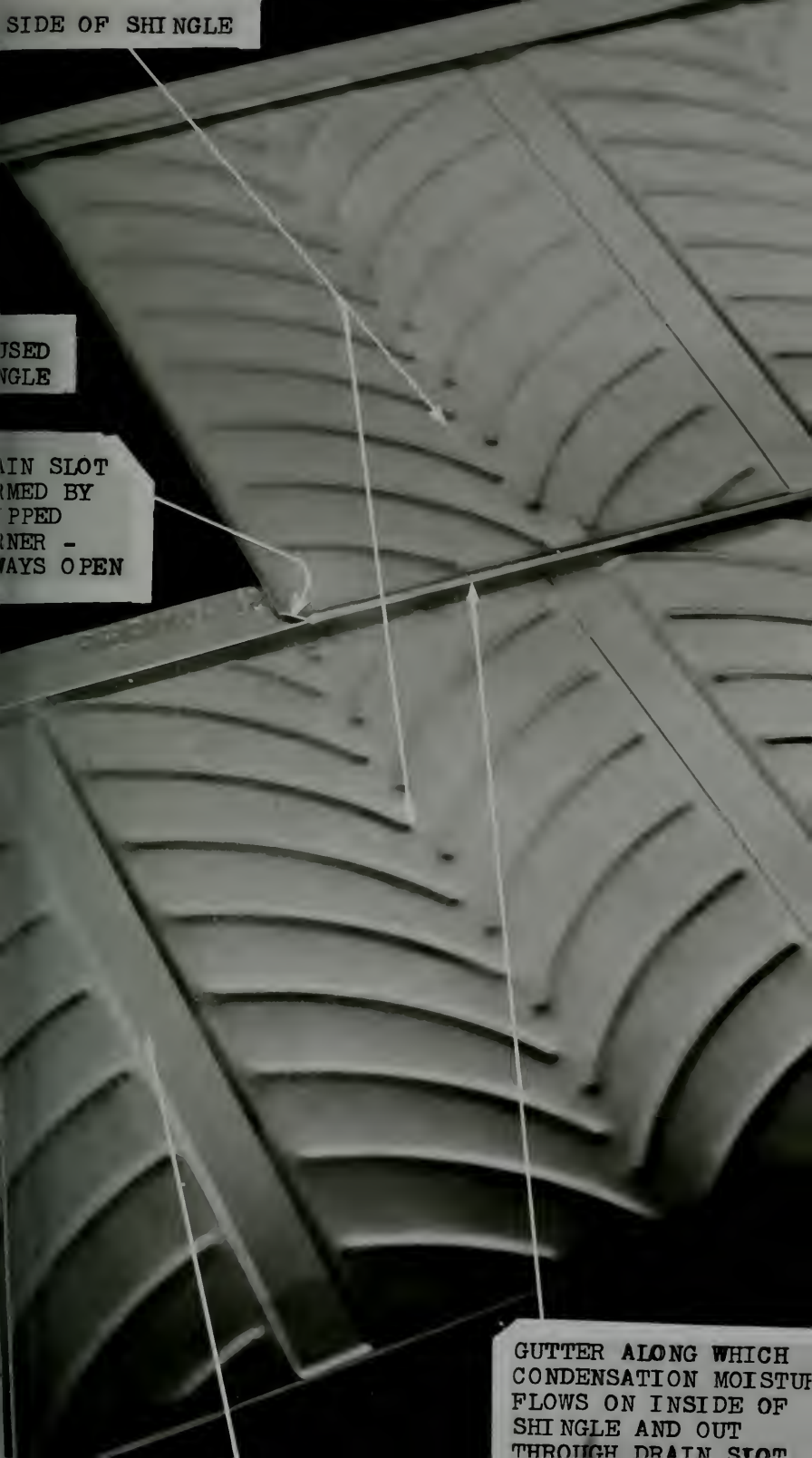
CONTACT BETWEEN
CORRUGATION AND
NEXT LOWER SHINGLE

SIDE OF SHINGLE

USED
SHINGLE

DRAIN SLOT
FORMED BY
LAPPED
CORNER -
ALWAYS OPEN

GUTTER ALONG WHICH
CONDENSATION MOISTURE
FLOWS ON INSIDE OF
SHINGLE AND OUT
THROUGH DRAIN SLOT



INVERTED CORRUGATION
OR INVERTED RIDGE

D.

UNDERSIDE
OF SHINGLE

ACCUSED
SHINGLE

E-WIDE
DAILY ACCESSIBLE
WE BROUGHT ABOUT
THE INVERTED
CORRUGATIONS FOR
SURE TO RUN INTO
THROUGH THE TIGHT
JOINT TO THE GUTTER

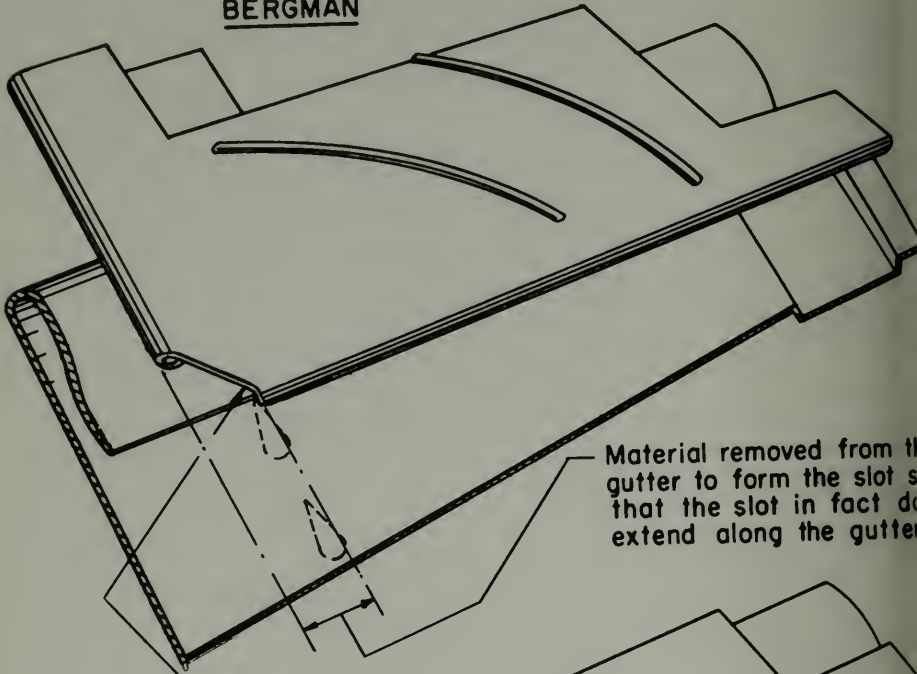
CONTACT BETWEEN



SKETCH E

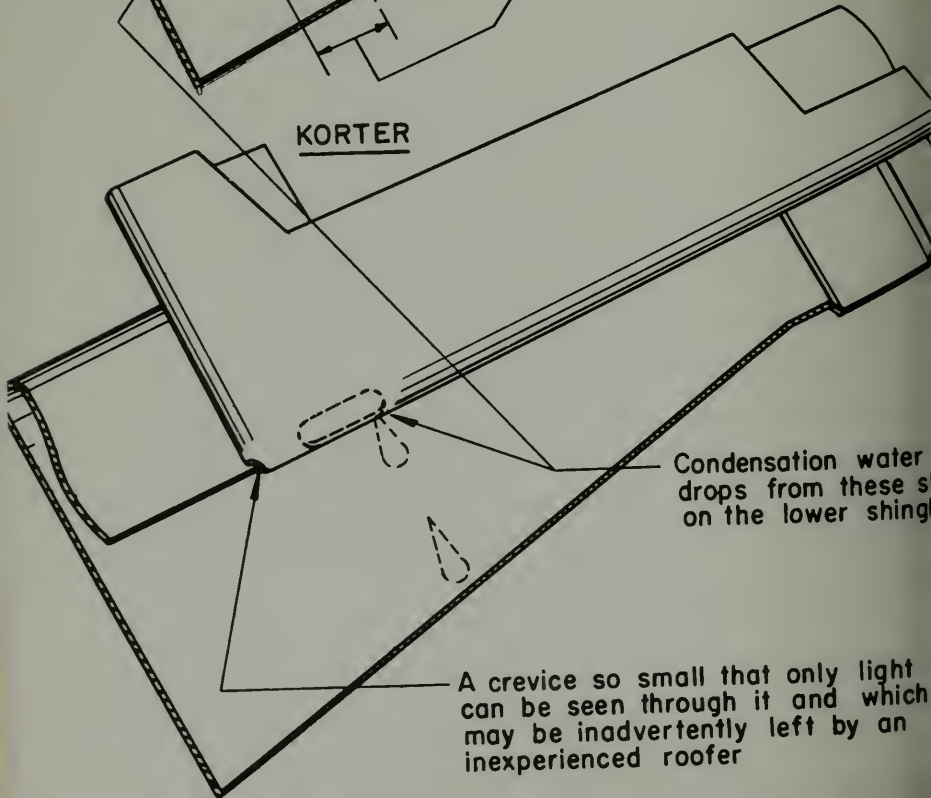
The Bergman shingle operates exactly the same as the Korter shingle insofar as the elimination of water of condensation is concerned — the structure is also functionally the same

BERGMAN



Material removed from the gutter to form the slot so that the slot in fact does extend along the gutter

KORTER



Condensation water drops from these spots on the lower shingle

A crevice so small that only light can be seen through it and which may be inadvertently left by an inexperienced roofer

We ask the Court particularly to note in D that Bergman has *deliberately inverted the vertical corrugations or ridges on his shingle to form a contact with the upper surface of the scroll of the lower adjacent shingle in order to provide a wide, readily accessible space so as to permit the moisture on the inside of the shingle to run into and through the "S" joint to the gutter formed by that joint.* The drain slot indicated on C on the front side of the accused shingle is formed *by clipping the corner, as indicated on the photograph, so that a portion of this slot extends along the gutter.* The removal of this material and the similarity between Bergman's slot and Korter's slot is vividly shown on the pen and ink sketch designated Sketch E.

Richardson testified (Tr. 266):

"A. There are two features * * * of course, I could not tell what Mr. Bergman or any one else was thinking about when they did this thing, but there are two elements of the structure of this shingle that would lead anyone to suspect it was made for the purpose of making a drain slot which would function in an equivalent manner to the Korter drain slot. The first item of suspicion is the cutting back of this corner of the shingles so much farther than necessary for the interlock and actually clipping the corners, the exposed corners, off the shingle. * * *"

Referring to Korter's combination claim, we find, as explained by Richardson (Tr. 108 to 110), that the Bergman shingle (PX 3) constitutes "an aluminum shingle of rectangular shape," the shingle does comprise "a substantially flat sheet of metal of uniform thickness" and that the shingle as a whole does lie "substantially in the same plane." There are corrugations extending "laterally of the shingle" (two in number) and these corrugations

form "ridges on the inner face of the shingle" because they extend downwardly from that face.

The lateral edges of the Bergman shingle (i.e. the left-hand and the right-hand edges) are reversely turned and they have "curved outer edge portions for interlocking the shingle with the laterally adjacent shingles." The top and bottom edge portions of his shingle are reversely turned because the top edge is folded forwardly and the bottom edge is folded underneath and these turned edge portions constitute half-round portions with the lower edge thereof "forming a gutter" and adapted to engage "with a reversely curved top edge portion of a lower adjacent shingle to form a close fit there between."

Bergman's shingle has a fastening tab at the upper right-hand corner "integral with the shingle" and extending from an upper corner of the shingle for securing the same to a roof structure. His shingle also has a drain slot at the left-hand end of the gutter and, as explained by Richardson, "Now, that drain slot can be seen through there. There is a cut-off end of the thing, and the whole thing has been enlarged to open up and make adequate drainage at all times," when the witness was referring to the large spaced edges formed between the vertical and horizontal lips at the lower left-hand corner of the shingle and also the diagonally clipped corner of the shingle which was deliberately provided in the Bergman shingle to cooperate with the wide-spaced edges of the said lips to provide an over-open drain slot.

Bergman's *wide slot* formed by the *clipped corner* at the lower left-hand end of the shingle is no accident. It was deliberately provided to emulate Korter's drain slot but placed in a slightly different position and of a different shape (Tr. 104, 105).

Defendant Bergman in his pre-trial deposition (PX

4, p. 14) admitted that the accused shingle does have a drain slot (as recited in the Korter combination claim) in or forming part of the gutter:

“A. We have our drain slots on the end.

XQ. You also have a drain slot there, do you not, in the gutter?

A. Well, I have heard you call it a bleeder, I will call it a bleeder or if you want to call it a drain slot, you can. It is the edge of the seam.”

Bergman could not show that any element or its function of Korter's combination claim was absent from the accused shingle.

Myers v. Beall Pipe & Tank Corporation, 90 F. Supp. 265:

“It is fairly obvious that a great deal of effort had been gone to in order to change the form so that it would look different than the Myers patent, but *imitation of essentials is the truest flattery and also points to the reality of infringement.* * * *”

United States Rubber Co. v. General Tire & Rubber Co., 28 F. (2) 104, 108, 109 (C. C. A. 6).

Also *Specialty Equipment & Machinery Corp. v. Zell Motor Car Co.*, 193 F. (2) 515-519 (C. C. A. 4) (appendix p. 1a).

An application of every element of Korter's combination claim to the accused shingle (PX 3) has also been indicated in diagrammatic form in plaintiff's exhibit 7 stipulated into the appeal record. The contents of this sketch stands unrefuted and was amply supported and explained by witness Richardson in Transcript 100-102.

It is significant that defendant Bergman admitted that his shingle does have “drain slots on the end,” which apparently Bergman contends “is also different from Korter's drain slot 21 because it is on the end” (Bergman's deposi-

tion, PX 4, p. 14). But the Court will note that Korter's claim is not limited to having the drain slot away from the corner, and would certainly include a drain slot at the end of the gutter in this terminology: "a drain slot disposed in the gutter of said shingle for draining water therefrom." The Trial Court and witness Richardson discussed this matter on page 263 of the transcript:

"The Court: The other side says that their shingle does not infringe because they don't have a drain slot. How do you reconcile that?

A. Well, they have a drain slot.

The Court: In other words, you say they have an equivalent?

A. That is right. There is nothing in the patent and there is nothing in the dictionary which says what shape or size or position a slot shall have. The patent says a drain slot. Now a slot is not always a drain slot, but a slot which necessarily drains and is disposed in the gutter and which drains the gutter is a drain slot in the Korter claim."

Bergman admitted in the Record (Tr. 234) that his shingle does have *downwardly* extending ridges, the same as Korter's element 12, and when pressed for the reason why he did not extend them upwardly as in the Miller patent but downwardly as in Korter, he said:

"A. Because it looked better." (Tr. 234.)

The real reason, as found originally by Korter, was to space the inner surface of the shingle from the upper curved portion of the lower adjacent shingle.

(1) Korter is entitled to a reasonable range of equivalents in regard to the position, shape and size of the drain slot as an element of the entire claimed combination.

The defendants cannot escape the charge of infringement by calling the drain slot in the Bergman shingle an

“open gutter end” as stated at pages 25, 30 and 32 of their brief. They argue that their drain slot is nothing more than a “bleeder” opening which is quite often left between metal shingles due to the inability of a workman to obtain a light-proof joint between adjacent shingles at the corner position.

However, the record below shows that when these small crevices or bleeder openings are left accidentally or intentionally between the shingles, they inevitably fill up with sand or dust in the air so that, regardless of whether there was initially a small drainage through the bleeder opening, it was only a question of time as to when the opening would be completely closed (Korter, Tr. 102, and Langville, Tr. 188). While these bleeder openings, when they are actually passing water, could in a general sense be considered drain slots, when they were closed they would no longer act as a drain slot (Tr. 123).

It was to this problem that Korter addressed his second application corresponding to the patent in issue, and he provided a “drain slot” in the same type of shingle that was shown in his earlier application Serial No. 776,332 that was superseded by the later application and which drain slot would never be clogged, or, in other words, **would always perform the function of a drain slot.** This statement is completely consistent with the Korter patent specification, page 1, column 1, lines 17 to 19 (referred to by defendants): “Figure 3 is a fragmentary perspective view of one corner of the shingle showing the drain slot which forms the basis of this invention.” Korter, in his second application changed the wording from “drain opening” in the first application to a “drain slot” which was so large that it could never become clogged. This is strictly in accordance with the definition of the word “slot” as

given in the American College Dictionary (1953) published by Harper, New York, which states:

“Slot: A narrow elongated depression or aperture, especially one to receive or admit something.”

Thus the term “slot” is intimately tied up with the idea of having an object pass through it, in this particular case the moisture of condensation which has collected in the gutter.

Richardson on cross examination said (Tr. 123):

“A. A slot—I don’t like to compete with Webster but a slot is an opening of some kind. A drain slot is a slot that drains. Now, the same slot could or could not be a drain slot, depending on how it functions.”

Bergman went through the same reasoning in providing his drain slot which was so large that it did in fact always constitute a “drain slot” under the above definition and it always serves to pass the water of condensation which flowed into it from his gutter.

However, regardless of whether Korter’s drain slot is merely a glorified bleeder opening, and regardless of whether Bergman had the right to enlarge the bleeder opening to form a drain slot, the fact remains that Bergman would still infringe Korter’s combination claim because he chose not only to employ a drain slot, but also the other five elements of Korter’s claim, including the inverted ridges or corrugations, all of which cooperate together to provide a result never attained before, according to all of the witnesses below, except in the case of the Belding patent which attained the result in an entirely different way and which has not been advanced by defendants on this appeal.

The range of equivalents to be accorded Korter’s claim, particularly in regard to the recited drain slot, was

explored by defendants' counsel in the court below on cross examination of expert Richardson (Tr. 300, 301):

“A. For goodness sake, Mr. Kolisch, I don't want to get all hectic about this, but I would just like to point out that the only reference as far as structure goes in the claim is ‘a drain slot disposed in the gutter of said shingle for draining water therefrom.’ And he has the entire breadth of that in his claim, anyway. There is nothing in the claim that says anything about the shape of the slot. It just is disposed in the gutter for the purpose of draining the gutter. And it is allowed and it is assumed to be valid, and there is nothing in the prior art that says that that combination with any form of slot in the gutter is in the prior art.”

Nowhere in the prior art were defendants able to show any opening at the end of a gutter of a metal shingle which would take care of the moisture condensate, under any and all conditions, and convey that condensate through an ever-open drain slot, as distinguished from a mere crevice or crack that might accidentally or incidentally be left at the corners of a shingle.

An accidental showing can never anticipate and this is especially applicable where the infringer takes the whole gist of the invention. *Frick Co. v. Lindsay*, 27 F. (2d) 59, 62 (C. C. A. 4) 1928; see also *Skelton v. Baldwin Tool Works*, 58 F. (2d) 221, 227 (C. C. A. 4) 1932. *Walker on Patents*, Deller's Ed., Vol. III, Par. 474, page 1718.

The form of Korter's drain slot 21, i.e. whether it is oval, elliptical, square, or even a slot with parallel sides as in Bergman, is *not* the indispensable thing. The feature that is indispensable is the fact that the drain slot must be disposed in the gutter of the shingle “for draining water therefrom,” as is set forth in Korter's claim. That particular function of draining water from the gutter has cer-

tainly been shown and demonstrated in regard to Bergman's slot which is effectively at the end of the gutter and, as shown in the demonstration (Tr. 108), does perform the function of allowing the condensation of moisture to flow under all conditions from the gutter to the exterior surface of the adjacent shingle below.

- (2) **The drain slot in the accused shingle cooperates with the other elements of that shingle in the same manner as the drain slot cooperates with the other elements of Korter's combination claim.**

It is sheer nonsense for appellants to concentrate their argument on the drain slot as if it were the only element of the combination. They certainly know better. *General Motors Corporation v. Kesling*, 164 F. (2) 824, 833 (C. C. A. 8) (appendix p. 3a).

Bergman's drain slot could not have performed as it did in the demonstration in the court below (Tr. 53) if there was no gutter and the latter would have been of no use if it were not for the spacing between the inner surface of the shingle and the upper surface of the joint, and this spacing would not have been made possible if it were not for the inverted corrugations so that all of these elements performed exactly in the same manner and for the same purpose as their counterparts in the Korter shingle.

B. All of the Important Elements and Functions of the Korter Patent Claims are Found in the Bergman Shingle.

(1) Transcript record proving infringement.

The identity of the *structure* as between Korter and Bergman shingles was shown by Richardson on Tr. 102 to 105.

The identity of the *function* of the Korter and Bergman shingles was demonstrated in Court by Richardson, using a garden spray to simulate the moisture of condensation (Tr. 106 to 108).

As a result of comparison of the two shingles and the Court demonstration, Richardson found every element of Korter's claimed combination in the Bergman shingle (Tr. 108 to 110).

(2) Bergman could show no material difference in the court below, or in his pre-trial deposition between his shingle and the Korter claim.

On pages 13, 14, 15 of his deposition (PX 4) Bergman said the only difference between his shingle and Korter's shingle is:

(a) "A drain slot which I do not have"

(b) "Korter has a curvature in his which I do not have"

(c) "Then we have this here lock" (referring to a U-shaped lock at the upper left-hand corner of his shingle which incidentally has nothing whatsoever to do with the structure or function of Korter's claimed combination)

(d) "Our marks are different" (meaning the design of the group of shallow corrugations)

(e) "The difference in weight or gauge of aluminum sheets."

None of these differences go to the specific elements which make up Korter's combination claim, except perhaps reference to the "drain slot." But in open Court, Bergman admitted on cross examination that his shingle did have a "drain slot" (Tr. 237)—it is obvious that it does. (See photograph C, following p. 8 of this brief.)

C. Defendant's Case, to Avoid Infringement, Appears to Be Built Up on an Alleged File Wrapper Estoppel—at Best a Flimsy Excuse.

- (1) No limitation on the breadth of the patent claim is caused by
 (a) The suspension of the prosecution of Korter's earlier application, Serial No. 776,332 (PX 28).

On page 25 of their brief, appellants have seized upon the statement "Figure 3 is a fragmentary perspective view of one corner of the shingle showing the drain slot which forms the basis of this invention" in the patent, as allegedly showing that the subject matter of the earlier case, Serial No. 776,332, in disclosing the bleeder openings at the end of the gutter did not form a basis for the patent claim. In effect they argue, and we think erroneously that Korter was forced to abandon his earlier application on account of the prior art and by reason of the fact that that application showed only so called "bleeder openings" and not a "drain slot," and from that, they deduce the startling statement that "Korter's sole contribution was a 'drain slot'" (p. 25 of appellants' brief).

If this were true, we wish to ask appellants as to what happened to the six features of the Korter claim of which the drain slot was only one feature? It is obvious that appellants have lost sight of the fact that the Korter invention as set forth in the claim, does not reside solely in one feature, but instead, in the six main elements set forth earlier in this brief and discussed later in connection with the prior art, all cooperating together to produce a new and unobvious result. Would they have the temerity to deny that the accused shingle does have a drain slot beginning at the lower left-hand end of the shingle and running along the gutter as is brought out by the photograph C, following p. 8 of this brief? Consequently refer-

ence to the file wrapper of either the earlier or later filed application for the purpose of determining the meaning of the recited "drain slot" will be of no help to appellants, and nobody in his right mind could deny that the Bergman shingle has a slot. Under these circumstances, *it is neither necessary nor proper to refer to the file wrapper for the meaning of the term which reads directly and without ambiguity on the accused shingle.*

The simple and matter of fact explanation of the reference in the patent as regards the basis of the invention being shown in Figure 3 is that anything of patentable subject matter found in the earlier application, Serial No. 776,332, is added to the improved drain slot disclosed in a later application (the patent in issue) so that the two disclosures which were co-pending, represent a composite disclosure and the patent claim allowed in the later application was sufficiently broad to read not only on the disclosure of the later application, but also on that of the earlier application (35 U. S. C. A. 120, appendix, p. 4a).

Korter's reference to the earlier application, in accordance with the requirements of the Code, was made in Col. 1, first paragraph of the patent.

The statement made by appellees on page 38 of their brief that "The abandonment of its first application (PX 28) * * * were expressed disclaimer of any drainage means such as open corners at the ends of the gutter like those of the accused shingle" is completely in error and directly opposed to the statement in Code Section 120 that a second application which is filed for the same invention or contains substantially the same invention of an earlier application shall be entitled to claim any subject matter common to both applications and is entitled to the benefit of the date of the first application provided the second application was "filed before the patenting or abandonment

of or termination of proceedings on the first application.” In the second place, appellants are apparently confused as to what is an “expressed disclaimer” in making the statement in their brief because obviously a disclaimer to be express must be signed by the inventor (35 USCA—Sec. 253) and *we defy appellants to find an express disclaimer in either one of the two Korter applications.*

It is true that Korter’s first application (DX 28) is what is technically called “abandoned,” by reason of the fact that the prosecution was suspended.

Appellants would like your Honors to believe—and we think erroneously—that in suspending the prosecution of the earlier application in favor of the second application, that Korter had actually dedicated the contents of his earlier application to the public. Nothing could be further from the truth than this. Korter’s earlier application was only *technically* abandoned in the sense that the prosecution was merely suspended in order that all of his effort could be placed upon his co-pending second application which eventually resulted in the patent.

All of the elements of the patent claim can be found in the earlier application, including the “drain slot” when the bleeder openings (“lateral drainage”) were actually relieving the gutter of the moisture condensate. It was only when these openings were temporarily clogged by sand or dust that the original case did not have a “drain slot.”

Walker on Patents, Deller’s Edition, Vol. I, at pages 358 and 359, states:

“Abandonment of an application may be actual, or it may be constructive * * * but abandonment of the application does not of itself constitute abandonment of the invention. * * * If, when withdrawing it, he intends to and does file a new application for the

same invention, the two applications are held to constitute one continuous application within the meaning of the law." *Godfrey v. Eames*, 1 Wall. (68 U. S.) 317, 17 L. Ed. 684 (1864); *Clark Blade & Razor Co. v. Gillette Safety Razor Co.*, 194 Fed. 421, C. C. A. 3 (1912).

See also *Smith v. Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 500.

The opposition has tried to give Your Honor the wrong impression that the earlier application had been abandoned in view of the Crawford patent 553,514 which it has offered as one of the defense patents in this suit. It is true that Crawford had been cited by the Patent Office against the earlier application, but it is equally true that Korter was strenuously fighting the Examiner's contention, in that he believed that the Patent Office tribunals had made a mistake in holding that the earlier claims were met by Crawford when he suspended the prosecution in favor of the continuing application.

Goodwin Film & Camera Co. v. Eastman Kodak Co. (District Court, W. D. N. Y.) 207 Fed. 351, 357 (appendix p. 5a).

Had the prosecution of the earlier application been terminated by the applicant and there was *no* copending application to carry the contested subject matter along, it might properly be said that the earlier application had been abandoned in view of the cited patent.

Appellants' statement (page 33 of their brief) that "Korter cannot resort to the doctrine of equivalents to recapture that which was required to be given up in order to obtain a patent" has no basis in patent law. File wrapper estoppel as to claimed subject matter does not attach until after *the patent has been granted*—in other words, no inference as to disclaimer or dedication to the public

can be made as to any subject matter that may have been contained in either the first or the second application, or both, until the final claim or claims of the grant had been worked out with the Examiner.

If the final claim as allowed, regardless of the number of copending applications which became necessary to obtain that allowance, and regardless of whether any of the applications were technically abandoned, reads squarely on the accused product, as in this case, there can be no estoppel in favor of the infringer anywhere along the application line. *Dean Rubber Mfg. Co. et al. v. Killian*, 106 F. (2) 316, 320 (C. C. A.—8) (appendix, p. 5a).

The earlier case disclosed five features in combination:

1. Corrugations or ridges as shown at 24.
2. The spacing between the inner face of the shingle and the upper surface of the scroll of the next lower adjacent shingle, as shown in Figure 4.
3. The fastening tab—element 22.
4. The gutter as shown at 11 in Figure 3.
5. The drain slot as described in the sixth object and again on page 4, line 18.

All five features have been carried along into the second case. No feature that is in the patent claim was ever dropped in the earlier case so that there can be no dedication to the public of any of the claimed subject-matter. The natural drainage at the corners of the shingle as described in the earlier application, comprises slots during the time that water is actually going through, i.e., when they are not clogged, because the term "slot" as used in the patent claim, refers to an opening of any size, even a "bleeder" (termed a "drain opening" in the earlier case) which remains open and actually drains water. However, if the opening becomes clogged by sand or dust, it cannot

be called a "drain slot," and it was for this contingency that Korter provided the large rectangular opening in his second application. And it was for this same reason that Bergman provided his rectangular opening which even Bergman has designated a drain slot.

In *Westinghouse Electric & Mfg. Co. v. Condit Electrical Mfg. Co.*, 194 Fed. 427, Judge Learned Hand adopted the law set forth in *Campbell Metal Window Corporation v. S. H. Pomeroy & Co.*, 300 Fed. 872, 874. (See appendix, p. 4a for excerpt.)

The Patent Office officially has gone on record as stating that none of the subject matter in the first application (PX 18, DX 28) was disclaimed because on the face of the file wrapper there is a note: "This application referred to in patent No. 2,631,552. Do not destroy (See order No. 3116, 400 O. G. 1) DO NOT DETACH," and by the statement made by the solicitor in the Patent Office on Paper No. 17 of the file wrapper which reads: "The above civil action was terminated on stipulation for Dismissal signed by counsel on March 13, 1953, with prejudice as to claims set out in the complaint but *without prejudice as to any claims the Patent Office may allow or has allowed in the application of the plaintiff here involved, or in any other application.*" (Signed E. J. Reynolds, Solicitor.)

(b) No limitations on the breadth of the patent claim is caused by the cancellation of claim 10 or any other claim in the patent file.

On page 38 of their brief, appellants allege that Korter has expanded his patent claim to include what was rejected by claim 10 in the second application. That is impossible for the simple reason that the patent claim as

allowed includes every element of claim 10. Nothing was lost by the cancellation of that claim.

Rejected Claim 10.

An aluminum shingle of rectangular shape

having flat seams along the lateral edges thereof

and having a backwardly turned half round gutter along its bottom end

said gutter having a reversely curved side

said gutter having a drain opening near the end thereof, the tip of said shingle having a shape similar to said bottom end and turned toward the weather side of the shingle

said shingles having grooves formed therein forming spacers between the underside of the shingle and the top side of the interlocked gutter and tip seams

The Patent Claim.

An aluminum shingle of rectangular shape

providing curved outer edge portions for interlocking the shingle with laterally adjacent shingles

the turned bottom portion forming a gutter

a drain slot disposed in the gutter of the shingle for draining water therefrom

the top and bottom edge portions of the shingle being reversely turned on opposite sides thereof

corrugations in said shingle spaced laterally of the shingle, said corrugations forming ridges on the inner face of the shingle * * * said corrugation ridges on the inner face of the shingle adapted to space said reversely turned top edge portion of the lower adjacent shingle from the inner face of said shingle

The above comparison of the patent claim which the Examiner allowed (and incidentally the same Examiner who had previously acted on claim 10) will show that the spacer ribs for facilitating drainage of condensation has been set forth in the patent claim in the same scope as in claim 10 except, perhaps, the function of these spacer ribs is indicated in a more precise manner. *Dean Rubber Mfg. Co., et al. v. Killian, supra.*

Korter did not at any time give up the subject matter of claim 10 that was rejected because at the time that it was cancelled (amendment dated October 7, 1952—Px 17) in the directions for cancellation of this claim, he said, "Cancel claim 10 *without prejudice or disclaimer of the subject matter* and substitute the following claim in lieu thereof," showing that the subject matter of claim 10 was carried over into the subject matter of claim 11. Claim 11 was rejected as being "indefinite and incomplete" (Office Action dated January 12, 1953) and then this claim was rewritten in the form of claim 12, which claim as slightly amended, constitutes the patent claim in issue.

Here, again, the claim as eventually allowed reads squarely on the accused shingle so that there can be no estoppel anywhere in the proceedings, and regardless of the cancellation of claim 10. *Campbell Metal Window Corporation v. S. H. Pomeroy & Co., supra. National Tube v. Mark, et al., 216 F. 507, 522 (C. C. A. 6).*

On page 22 of its brief, appellants allege that "The applicant acquiesced in this rejection by the Examiner * * * and no claim of comparable scope was ever submitted thereafter in the application." As a matter of fact, applicant did *not* acquiesce in the rejection because later the applicant re-inserted the same subject matter of claim 10 into the application as shown by the above catalog of elements, but in a more accurate and definite form, which the Examiner eventually allowed.

We realize that Your Honors will distinguish between "acquiesced in this rejection" as alleged by appellants and a condition in which an applicant had openly admitted that the subject matter was unpatentable. A mere acquiescence never precludes the reinstatement of claim 10 in its verbatim form or in an improved form from the accuracy and definiteness standpoints as long as the

reinsertion takes place prior to the actual grant of the patent. *Ex parte Collins*, 44 USPQ 82, 84 (appendix p. 6a).

The Board of Appeals decision was adopted by the District Court, S. D. New York, in the case of *General Electric Corporation v. Hygrade Sylvania Corporation et al.*, 67 USPQ 72, 75 (appendix p. 7a).

Also see book entitled *Patent Office Rules and Practice* by Leon H. Amdur (who is considered a well known authority on the intricacies of Patent Office Practice), Sec. 199c (appendix p. 7a).

Claim 10 under attack by appellants was *never* finally rejected but the subject matter was continuously being advanced before the Patent Office by the claim eventually allowed. *Baltzley et al. v. Spengler Loomis Mfg. Co. et al.*, 262 Fed. 423, 426 (C. C. A. 2) (appendix p. 5a); *Bullock Electric Mfg. Co. et al. v. Crocker-Wheeler Co.*, 141 Fed. 101, 110 (Circuit Court, D. New Jersey) (appendix p. 6a); *Dean Rubber Mfg. Co. et al. v. Killian*, 106 F. (2) 316, 318 (C. C. A. 8); *Ensign Carburetor Co. v. Zenith-Detroit Corporation*, 35 F. (2) 684, 686 (C. C. A. 2) (appendix p. 7a); *Anraku v. General Electric Co.*, 80 F. (2) 958, 960 (C. C. A. 9) (appendix p. 8a); *Lyon v. Bausch & Lomb Optical Co.*, 119 F. Supp. 42, 45 (District Court, W. D. New York); *Celanese Corporation of America v. Essley Shirt Co., Inc.*, 98 F. (2) 895, 896 (C. C. A. 2); *F. E. Myers & Bro. Company v. Goulds Pumps, Inc.*, 86 USPQ 12, 14 (District Court, W. D. New York).

(c) There are no intervening rights in favor of defendants.

There can be no intervening rights in favor of defendants by the cancellation of any of the claims either in the earlier or the later application because the sub-

stance of the rejected claims was carried through the prosecution of the earlier case filed September 1947 to the later filed case and then through the later filed case to the final form of the patent claim. In addition the record shows that the defendants did not make or sell the accused shingle until July 1952 (Bergman's pre-trial deposition—PX 4), and according to the record (Tr. 152), Bergman obtained the first information regarding the accused shingle from Korter himself as early as July 1950, when Korter had, at Bergman's request, shingled Bergman's house with precisely the same shingle as was shown and disclosed in the later application and was introduced into the record as PX 2.

Thus, in the present case, the Korter combination claim (patent in issue) reads directly on the accused shingle (PX 3) and the subject matter of this claim was being continuously prosecuted before the Patent Office, beginning with Korter's earlier application, Serial No. 76,332 and then simultaneously prosecuted during the proceeding of the Korter patent in issue, until the claim was formally allowed.

There can be neither dedication of the subject matter of that patent claim or any part thereof to the public—there can be no abandonment of the invention as covered by any part of the patent claim—and there can be no interfering rights established in favor of one who infringes the patent claim.

In *Campbell Metal Window Corp. v. S. H. Pomeroy & Co., Inc.*, 300 Fed. 872, 874 (District Court, S. D. N. Y.), Judge Learned Hand declared:

“I do not understand that this case meant to require me to go through all that was said in the endless communications between applicant and Examiners to gather piecemeal the intent of the grant as though I

were construing a correspondence. If so, what is the purpose of the final, formal instrument? * * * In any event, it is well settled by authorities binding upon me that in this circuit we do not look to exterior expression of intent, but treat a patent as we should will, a deed, or any other instrument intended to be a final memorial of the parties' intention." (Citing many authorities.)

Thus, Korter was the true inventor of the shingle—not Bergman—and Korter was, since September 1947, striving to patent the shingle, either through his earlier application or through his later application which eventually matured into a patent.

V. KORTER PATENT IS BELIEVED TO BE VALID.

A. Korter's Contribution of a Lifetime Shingle Made of a Non-rustable, Ordinarily Non-oxidizable Metal, Aluminum, to Supplant Hard-to-Manufacture Slate Shingle and Short-life Wood and Tile, Filled a Long-felt Want

As will be shown when discussing the patents advanced by defendants, Korter was the first to have given the roofing business an *aluminum* shingle, at least one of a practical character. No patent relied on by appellants discloses specifically aluminum, whereas Korter's claim is limited to *aluminum*.

The prior art used such metals as copper (Miller patent) which readily lends itself to solder for covering holes or leaks, or a shingle which required a great deal of work after it was laid on the roof, such as hammering the folded edges down so as to render it perfectly waterproof (such as Crawford), or making sure the joints are tight by filling them with cement (Lewando patents).

Korter's shingle is in finished form when laid on the roof—it is light in weight, water-tight without the use of

solder, welding or cemented joints, and is easy to install. Since aluminum does not rust, the roof lasts a life-time.

The fact that he did fill a long-sought want in the roofing field is attested to not only by the phenomenal success achieved by Korter in selling his shingles in quantity since 1948, his sales improving year by year (Tr. 103, 155), but by the large number of testimonials that he received and filed in the earlier patent application (PX 18, DX 29). Korter was the manufacturer chosen to apply aluminum shingles to the Blanding Dream House in Portland (1948) (Tr. 149) which was intended to represent the newest and most economical form of shingle.

Perhaps the most convincing testimony as to the newness and practicability of the Korter shingles was the proof that defendant Bergman had hired Korter to shingle his house with aluminum shingles in the summer of 1950 (Tr. 152). It was only two years later when Bergman formed his company, Perma-Lox Aluminum Shingle Corporation, to make aluminum shingles, after having observed the great success achieved by Korter, particularly in and around Portland, that he went into the shingle business and competed with Korter on a large scale.

Pacific Contact Laboratories, Inc. et al. v. Solex Laboratories, Inc., 209 F. (2) 529, 532 (C. C. A. 9). *Claude Neon Electrical Products, Inc. v. Brilliant Tube Sign Co. et al.* (C. C. A. 9), 48 F. (2) 176. *Lyon v. Bausch Lomb Optical Co.*, 224 F. (2) 530, 535 (C. C. A. 2). *Kendall v. Trico Products Corporation*, 31 F. (2) 522, 524 (C. C. A. 3).

In the *Pacific Contact Laboratories* case, *supra*, Circuit Judge Stephens (C. C. A. 9) said:

“It must also be noted that the Patent Office, only after making a close examination of Tuohy’s claim of

invention, granted him a patent on the corneal lens. And there is evidence that the corneal lens *met with wide acceptance and success only after Tuohy put it on the market.* We, therefore, conclude that the district court's finding that Tuohy invented the corneal type lens is not clearly erroneous."

B. Korter's Claim Contains Ten Features All Cooperating Together to produce a New and Unobvious Result of Getting Rid of Moisture Condensate From the Inner Side of a Metal Shingle.

The elements of Korter's claim are:

(1) An Aluminum Shingle of Rectangular Shape, said Shingle comprising a Substantially Flat Sheet of Metal of Uniform Thickness and the Body of Which Lies Substantially in the Same Plane;

(2) Corrugations in said Shingle Spaced Laterally of the Shingle, said Corrugations forming Ridges on the Inner face of the Shingle;

(3) The Lateral Edges of the Shingle being Reversely Turned on Opposite Faces of said Shingle providing Curved Outer Edge Portions for Interlocking the Shingle with Laterally Adjacent Shingles;

(4) The Top and Bottom Edge Portions of the Shingle being Reversely Turned on Opposite Faces thereof;

(5) Each of said Top and Bottom Turned Edge Portions comprising a Half-Round portion, one Side of which is Tangent to the Plane of the Shingle and the Other Side of which Terminates in a Reversely Curved Portion;

(6) The Turned Bottom Portion forming a Gutter;

(7) And the Reversely Curved Portion thereof being engageable with a Reversely Curved top Edge

Portion of a Lower Adjacent Shingle to form a Close Fit Therebetween;

(8) A Fastening Tab Integral with the Shingle and Extending from an Upper Corner of said Shingle for Securing the same to a Roof Structure;

(9) And a Drain Slot Disposed in the Gutter of said Shingle for Draining Water therefrom;

(10) Said Corrugation Ridges on the Inner Face of the Shingle adapted to Space said Reversely Turned Top Edge Portion of the Lower Adjacent Shingle from the Inner Face of said Shingle so that Moisture can Travel along the Inner face of the Shingle and into said Gutter.

We wish to call particular attention to features (2), (5), (6), (8), (9) and (10) above.

The manner in which each of the ten elements read upon the Korter patent is shown in detail in PX 6 stipulated into the record on appeal.

The patent claim carries the presumption of validity under the law (35 USCA Sec. 282) and before the claim can be rejected it must be shown that the combination of the ten elements, all cooperating together in the manner expressed in the claim and for the purpose stated, is found in the prior art. The Patent Office specifically allowed the combination claim over all of the patents on which appellants rely, except the two Lewando patents that were not mentioned during the prosecution of either the earlier filed or the later filed Korter application.

C. Korter's Claim is Believed to be Valid over the Miller Patent Considered Either Separately or in Connection with Birch et al.

- (1) Miller is indefinite, inaccurate and therefore violates the rule that any patent, alleged to anticipate, must be clear, precise and definite.

In their brief on appeal appellants appear to dwell more heavily upon Miller notwithstanding the fact that this patent was considered by the Examiner when Korter's claim was allowed. But Miller is no better as a reference than Crawford, which they emphasized in their demonstration in the Court below, because

(1) Figures 1 and 2 of the Miller patent are not consistent with one another as we will show, and

(2) Miller lacks not only mention of ridding the inner side of the shingle, throughout its length and breadth of moisture condensate but also lacks structure by which such result could be obtained as will be shown under the next heading.

But as to the indefiniteness of Miller and therefore its incapacity to serve as a reference, we invite attention to Figure 1 which shows a plan view of a blank from which the shingle is formed. Note particularly that there is a right angle jog or extension at the lower right and left hand corners of the shingle which is located at the end of a leader line 3.

Figure 2 is a top plan view of the shingle, bent to shape at the edges and made from the blank of Figure 1. Appellants called particular attention in their brief to what they say is a slot at the lower and right hand corner of the finished shingle. But we wish pertinently to inquire of appellants, and incidentally of Miller, as to what happened to the jog shown in Fig. 1 but absent in Fig. 2?

ay 27, 1941.

DIAGRAM F

T. D. MILLER

2,243,256

METAL ROOF COVERING

Filed April 25, 1938

2 Sheets—Sheet 1

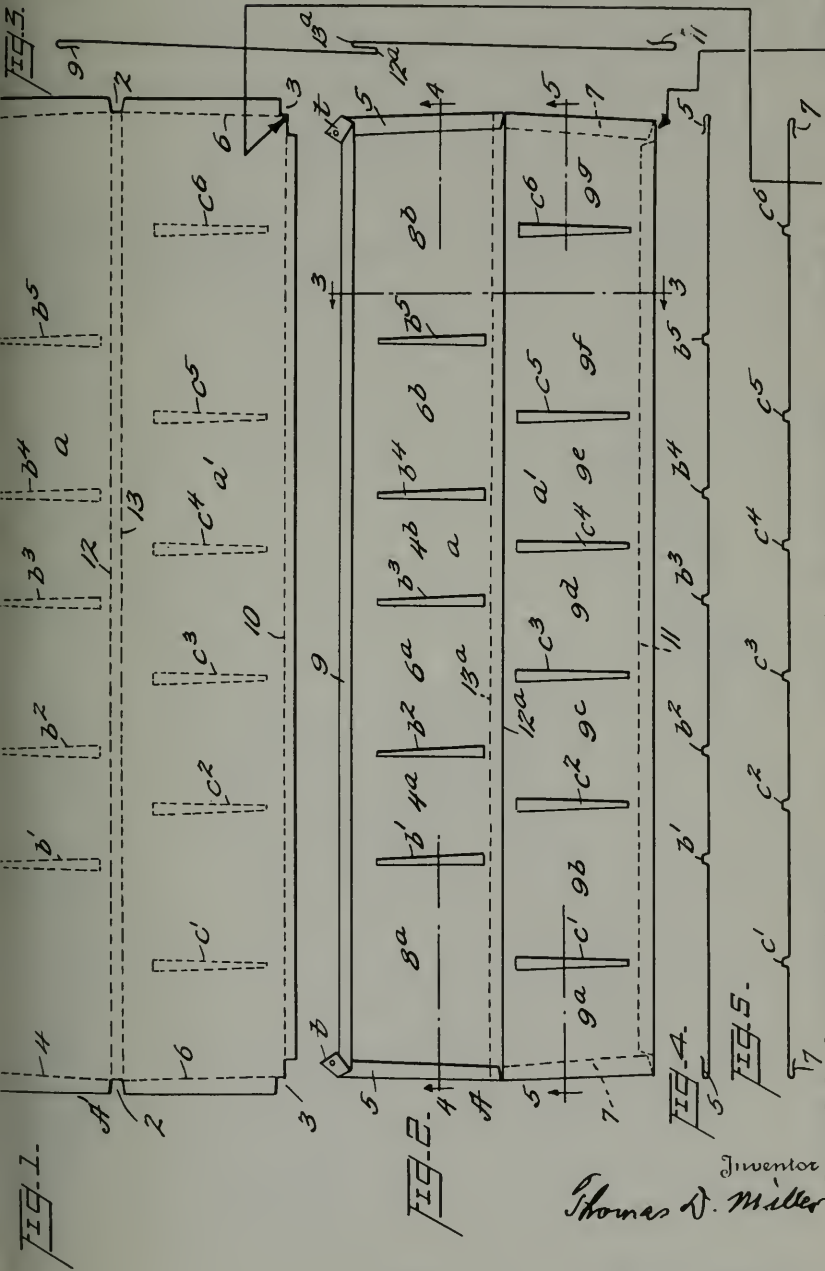


FIGURE 2 IS INCONSISTENT WITH FIGURE 1 BECAUSE FIGURE 1 SHOWS A JOG AT 3 WHICH WOULD SERVE TO CLOSE THE CORNER SEAM AS SHOWN ON PHOTOGRAPH . FIGURE 2 FAILS TO EVEN ACCOUNT FOR THE PRESENCE OF THE JOG . PATENT IS THEREFORE INCOMPLETE

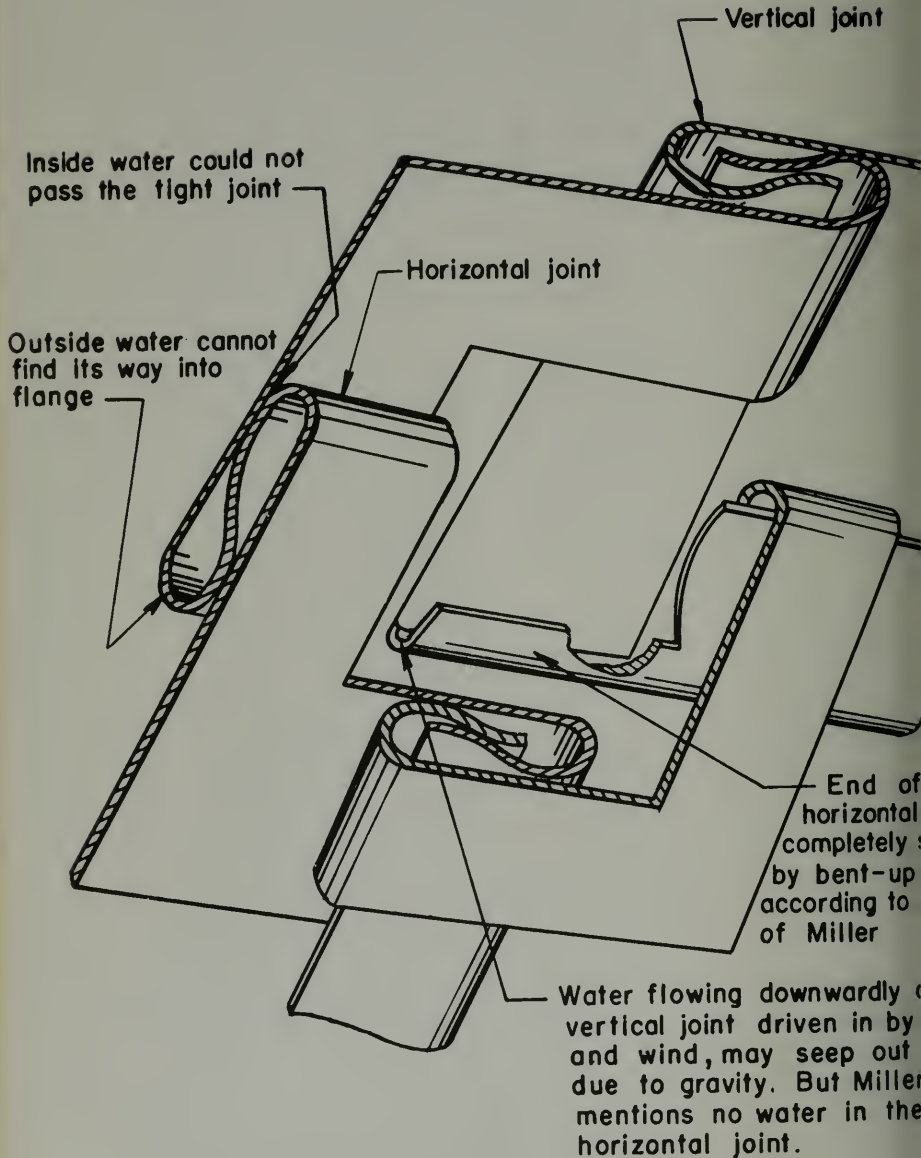
Inventor
Thomas D. Miller

Robert M. Watson
 Attorney

334

MILLER 2,243,256 SKETCH G

Corner Portion



When the shingle in Figure 2 is bent to shape, actually there was only one place where that jog could go in Figure 2 and that is to seal the diagonal spaces between the flanges 7 and 11 at each lower corner of this figure. In other words, the jog would completely close any opening at the corner between the flanges 7 and 11 except perhaps the small crevice or crack that could not be avoided when bent metal members are fitted together. The inconsistency between the showings of Figures 1 and 2 of Miller is brought out by the legends shown on a copy of the patent itself labelled as Sketch F. It is still further shown in perspective by a sketch of the corner portion of the Miller patent in which the position of the jog at 3 in connection with the finished form of the shingle in Figure 2 has been depicted as a perspective view. This showing is labelled Sketch G.

Appellants derive practically their entire case in contending that Miller is pertinent, from the showing of the space between the flanges 7 and 11 in Figure 2 of Miller, and in as much as the very point on which they rely is not at all clear from the patent on the matter of the presence or absence of jog 3 and is certainly inconsistent with the showing of the similar part in Figure 1, we submit that Miller is not a proper reference from which one merely skilled in the art could have derived Korter's claimed combination. *Schmeitz Wire Glass Co. v. Western Glass Co.*, 178 F. 977, 988 (Circuit Court N. D. Ill. E. D.).

- (2) Miller does not disclose all of the ten features of the Korter combination claim—it lacks at least five important features.

These five features are:

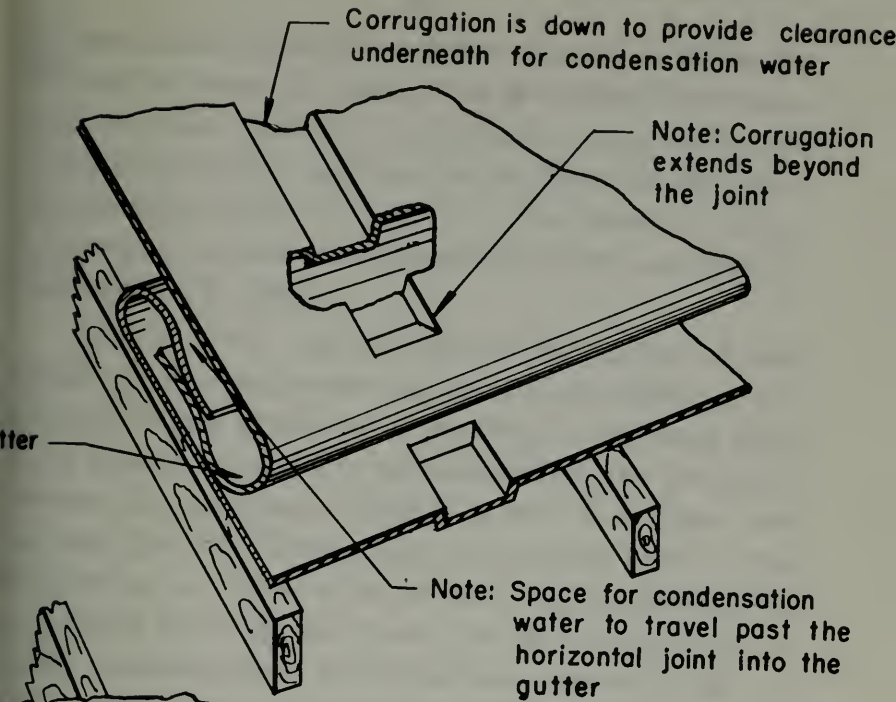
(1) “Said corrugations forming ridges on the inner face of the shingle”—Miller’s rectangular grooves B 6 etc. are not raised ridges on the inner-face of the shingle—ridges are only on upper side.

(2) “The lateral edges of the shingle being reversely turned on opposite faces of said Shingle”—in Miller as shown in Figure 2 the flange 5 at the left hand edge of the shingle is bent upwardly, as is also the flange 5 at the right hand edge of the shingle so that they are not reversely turned on opposite faces of the shingle. In the Korter patent as shown in Figure 1 the left hand edge of the shingle is turned downwardly and the right hand edge of the shingle is turned upwardly—hence the phrase “the lateral edges of the shingle being reversely turned on opposite faces” which clearly Miller does not have.

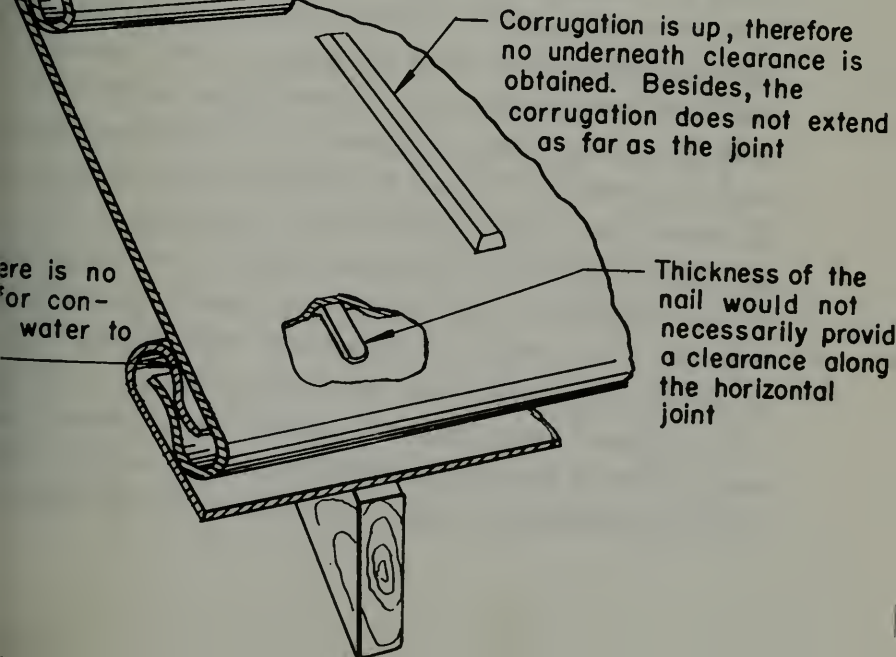
(3) The term “bottom portion forming a gutter”—Miller purposely describes the bottom portion 11 as an “underturned flange” (Column 2, line 25)—not as a gutter—because *it cannot be a gutter unless water flows through it*. In Miller, it is impossible for water to reach the flange because there is no spacing between the upper surfaces of the scroll forming the “S” lock and the inner surface of the shingle by which water could flow along the inner surface into the flange. This has been brought out more clearly by the sketch designated Diagram H which compares the gutter effect of Korter with the mere flange effect of the Miller patent in that in Korter, as indicated by the legends, the downwardly extending corrugations provide a space to accommodate the moisture conden-

KORTER 2,631,552

SKETCH H



MILLER 2,243,256



sate and allow it to reach the gutter, whereas in Miller, the "S" lock as shown in Figure 9 of the patent firmly contacts the inner surface of the shingle (shown at 9) and thus prevents any water from flowing down the interior of the shingle past the "S" joint into the flange. A flange is not a gutter unless it accommodates water, according to Richardson (Tr. 286).

(4) "A drain slot disposed in the gutter of said shingle for draining water therefrom"—in Miller there is no need for any drain slot in the flange 11 because there is no leakage of moisture condensate into the flange for reasons already stated. While it is true that Miller does mention that his "interlocking connections between the shingles as so formed as to prevent the free drainage of rain water that may be driven into said connections"—Miller is talking about the *outside rain that is driven into the vertical joints*—not the horizontal joints—and due to the velocity or driving force of this rain water passing down the interior of the vertical joints such water is forced outwardly at any crack or crevice that might be found at the corner joints of the shingle. But that does not mean that when it isn't raining the slow moving moisture condensate which might form on the inner side of the Miller shingle would find exit through the same cracks or crevices because it could not reach the flange 11 to travel to these cracks or crevices for the reasons shown on Sketch H. Moreover, such cracks or crevices would undoubtedly clog or close up, except on a rainy day, so that even if the water should reach the flange 11, there would be absolutely no assurance that such water would be relieved at the corner joints. Korter (Tr. 150), and Langville (Tr. 188), both said that the crevices could not be relied upon to expel the slow moving moisture condensate which ob-

viously is present on a clear non-rainy day as on a day when such cracks or crevices might have been opened by the downward moving rain water that had penetrated the vertical joints and were using these joints as a down spout.

(5) "Said corrugation ridges on the inner-face of the shingle adapted to space said reversely turned top edge portion of the lower adjacent shingle from the inner-face of said shingle and into said gutter"—in Miller the corrugation ridges are on the *outer* face of the shingle—not on the *inner* face—cannot perform Korter's function. Moreover, in order to serve as a spacing means between the inner-face of the shingle and the upper surface of the inter-locking scroll it is necessary that the corrugations shall extend as far as the joint. But in Miller, as shown in Figure 2, the corrugations stop short of the lower edge of the shingle so that even if these corrugations were located on the inside of the shingle rather than on the outside, they still would not serve to space the top edge portion of the lower adjacent shingle from the inner-face of the shingle to provide a path over the length of the shingle through which the moisture condensate could freely pass. This point is brought out vividly by the Sketch H at page 34 noting that in the upper portion of the sketch, in Korter, the corrugation extends downwardly and beyond the joint, whereas, in Miller, the corrugation is up and terminates far short of the joint.

(3) Miller is not concerned with the problem that Korter solved, namely the elimination of moisture condensate moving slowly in the vertical direction but along the entire length and width of each shingle. Therefore, Miller cannot show apparatus by which the problem could be solved.

Miller makes not one iota of mention (Tr. 260) or suggestion of ridding the inner-surface of the long, double width shingle of condensed moisture. In fact, he failed to mention the use of a gutter along the lower edge of his shingle and definitely lacks a drain opening in the missing gutter. Miller calls his lower bent up edge 11 "a flange"—not a gutter because it could not constitute a gutter unless there was water to be conveyed along the flange. Richardson testified "a gutter is a particular kind of trough that has a flow in it" (Tr. 286). There is *no* water in Miller's horizontal flange 11 so that it cannot constitute a gutter.

To be sure Miller does mention "the interlocking flanges of the shingles are not close fitting and do not hold water by capillary attraction to any extent. As best shown in *Figures 7 and 8, the end flanges are bent* so that they interlock with a minimum amount of surface contact with one another and with the bodies of the shingles, thus permitting *free drainage of water* and facilitating the sliding of one shingle with respect to the adjacent shingles when the shingles are being assembled on a roof." (p. 2, Col. 2, ll. 66-73.)

The "water" mentioned is defined on page 1, col. 1, l. 13 of the patent, as being "rain-water."

It is therefore clear that Miller was not referring to moisture condensate which is residual on the entire inner-surface of the shingle, but instead, he is referring to rain beating against the *vertical* joints and obtaining entrance to these joints which serve as "spouts" (Tr. 288). Figures

7 and 8 of the patent show only vertical joints 5, 7—not the horizontal joints 9, 11.

It will be understood that when rain in any quantity gains entrance to Miller's vertical joint, as in a driving storm, the rain will *rush* down the vertical joints since they are all in line with one another (See Figure 6 of the patent) and to some extent communicate with one another through any corner crevice that may be present at the bottom of these vertical joints or through any opening caused by the looseness between the parts of the vertical joint. If these cracks or crevices become temporarily clogged during fine weather, due to dust and sand in the atmosphere the rush of water downwardly would wash the crevices open in rainy weather. But this is not true of moisture condensate which moves slowly in driblets or beads along the entire inner-surface of the shingle—has no force of movement and only little velocity, and as explained by Korter (Tr. 102) and Langville (Tr. 144) could not unclog a corner crevice or crack.

Your Honors may recall the wetness of a vitreous toilet tank that contains cold water in a warm bathroom, and in which this surface dampness gives rise to sweating that moves slowly over the outer surface of the tank to form beads at the lower edge of the tank. These beads eventually drop as they get larger and become a great nuisance on a tile floor. The moisture of condensation considered in the Korter patent is quite similar to this phenomenon as far as the movement of the condensate is concerned. It slowly moves over the inner-surface of the shingle, and ever so slowly along the gutter so that the slightest obstruction at the end of the gutter would prevent further movement of the collected moisture or sweat. But Miller's problem is entirely different in that he is dealing with leakage of rain water into the shingle and in par-

ticular into the vertical joints of the shingle so that the rain water of which there may be considerable which enters the vertical joint, particularly if the latter were loose and rushes down these joints to seek an exit through any crevice or space that can be found along that joint or may pass from one shingle to the next through the aligned vertical joints before it finds an exit.

Miller makes no mention of getting rid of the moisture of condensation which is more apt to be present on a fine day than during a rainy spell to which the patent is limited. It is, of course, possible that any crack or crevice in the vertical joint of the Miller patent may be completely closed or plugged as far as any water moving in the horizontal direction is concerned in which case the crack or crevice does not perform the function of a "slot" and yet as far as the fast moving downwardly propelled rain water is concerned the same crack or crevice would constitute a slot. But Korter's invention is directed to the use of a slot that is open at all times to the slow moving, less forceful moisture condensate which starts on the inside of the shingle and collects only in horizontal gutters.

The problem which Korter solved arises in fair weather—and is brought about by the difference in temperature on the opposite side of the aluminum shingle (Tr. 91).

In the celebrated case of *Topliff v. Topliff*, 145 U. S. 156, in considering the absence of the problem and its solution in a particular patent, the Court declared:

"It is not sufficient in order to constitute an anticipation of a patented invention, that the device relied upon might, by modification, be made to accomplish the function performed by that invention, if it were not designed by its maker, nor adapted, nor actually used for the performance of such functions."

Coffin v. Ogden, 18 Wall. 120, 21 L. Ed. 821 (appendix p. 8a); *Loom Co. v. Higgins*, 105 U. S. 580, 591 (appendix p. 8a); *N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co.*, 25 F. (2d) 659, 663 (C. C. A. 6) (appendix p. 8a); *Gordon Form Lathe Co. v. Walcott Machine Co.* 32 F. (2) 55, 58 (appendix p. 9a).

- (4) The transcript record shows that Miller cannot anticipate the Korter claim.

Langville (Tr. 194) admits that the Miller patent does not show aluminum to which Korter's claims are directed.

In the transcript 205, Langville also admits that:

"A. I don't see in the patent where there is anything mentioned about condensation, in the Miller patent. I fail to see it. I might have missed it in reading it."

Richardson testified:

"Q. Is there anything stated in the Miller patent * * * in connection with the water of condensation and manner of ridding the same, sir?"

A. I don't remember anything at all of that kind. However, of all of the diagonal shingles and the makers of diagonal shingles, Miller was concerned with his vertical joint or getting water down the roof' (Tr. 258.)

- (5) The argument set forth in appellants' brief, pages 44 to 47, as to the alleged pertinency of Miller is spurious.

On page 44 of their brief, under the heading of Miller 2,243,256, appellants have made no entry of any element in Miller that would correspond to the rectangular form of an aluminum shingle in the Korter patent. This is for the reason that Miller does not show an "aluminum" shingle as was admitted by Langville (Tr. 194).

On page 45, under the horizontal entry No. 2, it will be noted that appellants admitted that Miller does not show "said cracks forming ridges on the inner-face of the shingle" because there is no entry (except a small star) opposite this item in the second column of elements. The star apparently refers to corrugations 22a on the inner face of a shingle shown in the *Birch et al.* patent which will be discussed in detail hereinafter but it is sufficient for the moment to state that this particular patent was withdrawn from the appeal by appellants in the Pre-trial Order (Tr. 35) and by this withdrawal, appellants have already admitted the non-pertinency of the patent.

Under the horizontal entry labelled 3 appellants contend that the recitation in Korter's claim "the level edges of the shingle being reversely turned on opposite faces of said shingle" is satisfied by Miller's "reversely turned flanges 5, 7, 9 and 11." This is not true. Please note that in Korter this wording reads: "Upon the down turned left hand edge of the shingle shown in Figure 1 and the up-turned right hand edge 17," whereas, in Miller, flanges 5 at the lateral edges of the upper portion of the shingle, which would correspond to Korter's lateral edges, are *not* reversely turned but *instead are turned in the same direction.*

In regard to feature 8 appearing on page 46 where appellants contend that Miller's flange 11 constitutes a gutter, this is completely in error for reasons stated hereinbefore as it has been shown that there is never any water in the flange to have it constitute a gutter and Miller practically admits such in calling it a *flange* instead of a gutter.

On page 47 under Feature 11, appellants allege that the jog at 3 in Figure 1 constitutes a "drain slot." Nothing could be further from the truth than this because actually that jog would close up the diagonal space between flanges

7 and 11 shown in Figure 2 when the shingle was bent out of the blank shown in Figure 1. This has been brought out illustratively by the photographs I, J.

On photograph I, it will be noted that in the blank sheet of metal, the jog 3 in Figure 1 of Miller has been provided as indicated but when this job is bent up at the corner, as also shown in the same photograph, it completely covers the space between the adjacent edges of the flanges 7, 11 of Figure 2 of Miller so if there were any water in flange 11 (we strenuously deny that there is any) such water could not be relieved at the space between the flanges 7 and 11.

The same condition has been shown in photograph J which typifies the position of the jog 3 as closing the space between flanges 7 and 11 of Miller's Figure 2 at the joint where the lower half of the Miller shingle is inter-locked with the upper half of the next right adjacent shingle and is also inter-locked with the upper half of the lower adjacent shingle to form a joint between four adjacent edges as seen in Figure 6 of the patent. It will be noted in the photograph J that the jog completely closes any opening that might have been present between the flanges 7 and 11 shown in Figure 2 of the Miller patent.

However, we do not deny that there may be a crack or crevice present at the extreme corner position and communicating with the vertical joint in Miller in order to relieve any rain water that might have been driven into the vertical joint. But this crack or crevice in all probability would be clogged insofar as any moisture condensate is concerned, should such condensate reach Miller's flange 11 which we strenuously deny.

Also on page 47 under the same Feature 11, appellants contend that the heads of nails 15, 17 in the Miller patent serve to space the inner-face of the shingle from

MILLER PATENT
NO. 2,243,256
FIGURE 1

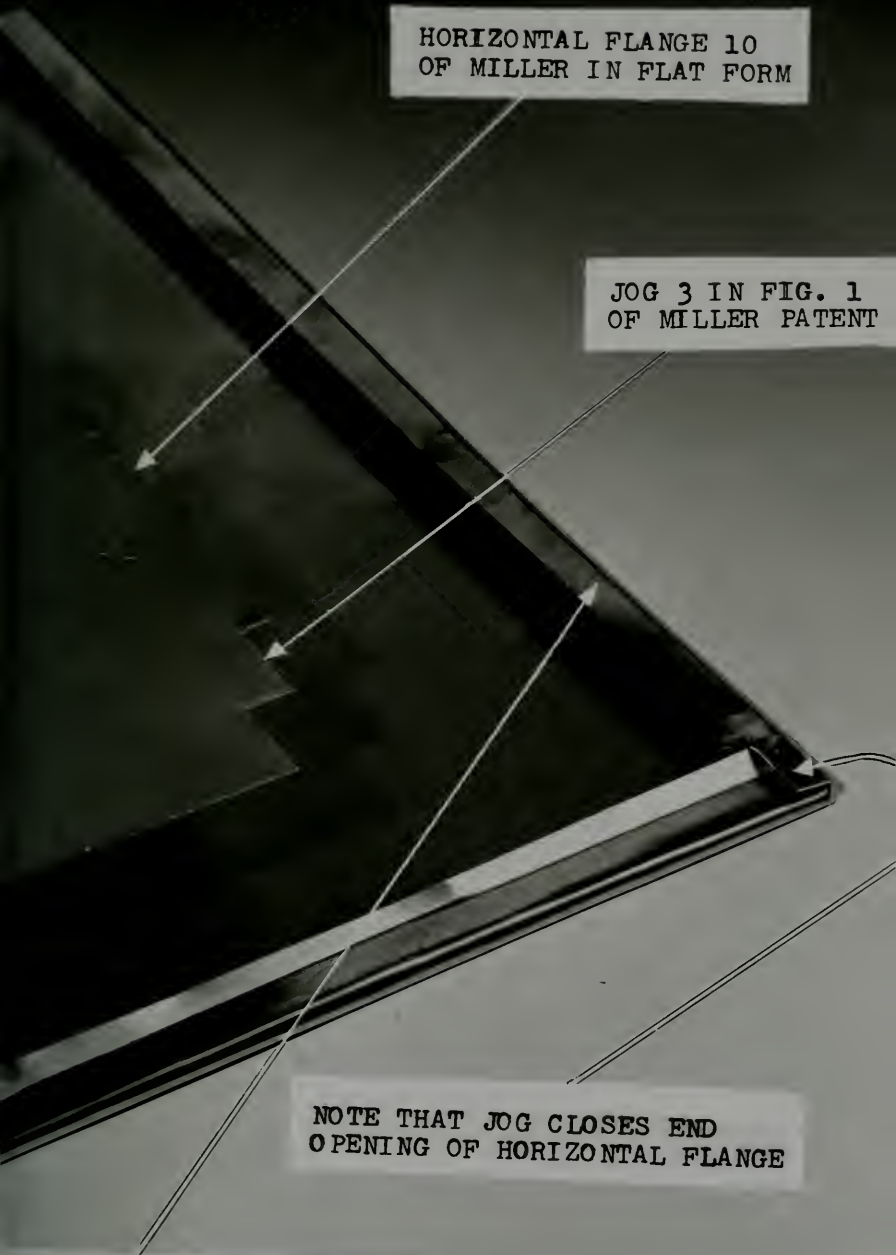
I.

HORIZONTAL FLANGE 10
OF MILLER IN FLAT FORM

JOG 3 IN FIG. 1
OF MILLER PATENT

NOTE THAT JOG CLOSES END
OPENING OF HORIZONTAL FLANGE

HORIZONTAL FLANGE 10 OF
MILLER IN BENT-UP FORM-



SHINGLE

J.

MILLER PATENT
NO. 2,243,256
FIGURE 6

SHINGLE WITH
MIDDLE SEAM



ER PORTION
MIDDLE

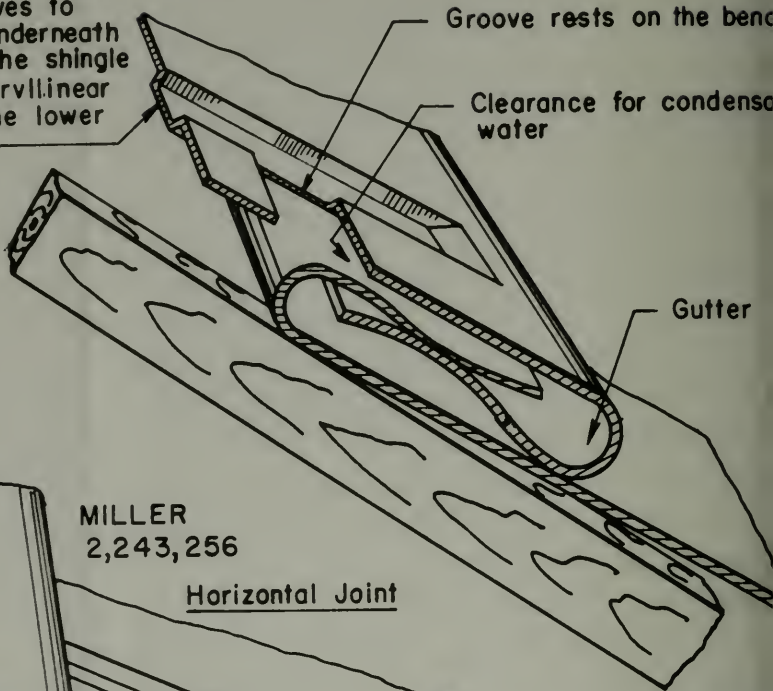
NOTE HOW JOG 3 OF MILLER
FIG. 1 SEALS AND PREVENTS

KORTER 2,631,552

SKETCH K

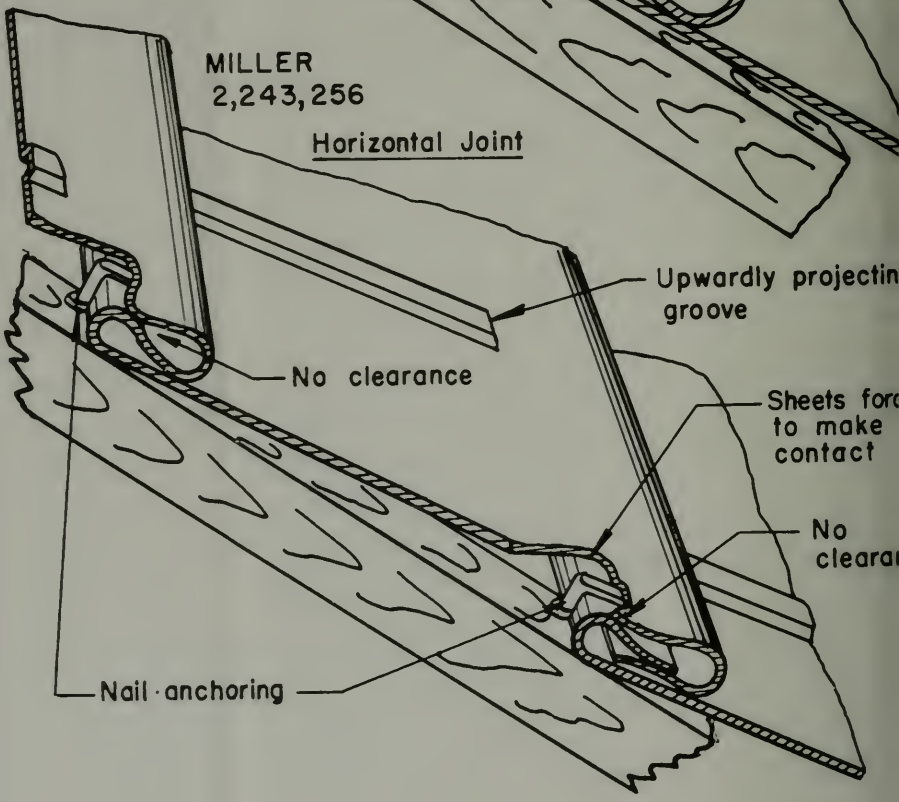
Horizontal Joint

Downwardly projecting groove (serves to space the underneath surface of the shingle from the curvilinear portion of the lower shingle)



MILLER 2,243,256

Horizontal Joint



the top edge portion of the lower adjacent shingle. Will your Honors kindly note that earlier in the catalogue appellants were attempting to combine Birch et al., which shows a downwardly projecting corrugation with Miller in order to provide the spaces and yet under Feature 11 they reverse themselves in now contending that these spaces are provided by the heads of nails 15, 17 in Figure 10 of Miller?

We need hardly remind the Court that Miller makes no mention or suggestion that these nail heads do space the inner surface of the shingle from the upper surface of the joint of the lower adjacent shingle. In fact, Figure 10 shows that they do not, because the inner-facing of the shingle rests directly upon the nail head.

Sketch K indicates the manner in which the inner surface of the shingle contacts the upper surface of the curved joint of the lower adjacent shingle except at the very limited position of the nail head. Please note the legend "no clearance" in the lower of the two figures on sketch K. Then compare the fact that Miller shows no clearance or space through which the moisture condensate could flow with the sizeable space or clearance for condensate water in Korter's diagram on the same sketch brought about by the downwardly extending grooves that rest upon the bend of the joint.

We defy appellants to show or prove that Miller has any spacing whatsoever between the inner surface of his shingle and the upper surface of the bend of the joint of the lower adjacent shingle. The nail head situation advanced by them in their catalog of elements on page 47 is only one of imagination (there was no testimony developed on this point in the Court below) and their contention is distinctly disproved by the sketch K as finding no basis in the Miller patent.

(6) Korter's combination claim was specifically allowed over Miller by the Patent Office. The burden of proving the patent claim invalid is on appellants—have not sustained burden.

The Miller patent was cited by the Patent Office during the prosecution of the Korter case. In fact the Examiner, as shown by the various actions, went into the Miller patent thoroughly and also, incidentally, arranged a prospective combination with Miller and Birch which he later discarded. The patent claim was allowed over Miller and carries with it the presumption of validity, not only as an issued patent under the Code (35 USCA Sec. 282) but also as being valid over Miller.

We also wish to point out in the same connection that the Birch, Slaughter, Cusack, Pruden, Crawford and British de Sincay patents discussed hereinafter are also contained in the Korter patent file or the earlier Korter application so that the presumptions of validity apply to each of these cases.

Hydraulic Press Mfg. Co. v. Ralph N. Brodie Co. et al. (District Court, N. D. California, S. D.), 51 F. Supp. 205, 59 USPQ 268, affirmed by Ninth C. C. A. in 151 (2) 91, 94 (appendix p. 9a for complete excerpt):

“Both patents were regularly issued. Hence both patents and claims thereof were presumptively valid. * * * All these claims were for combinations. Appellants alleged, in substance and effect, that these combinations were not new, and that therefore the claims were invalid for lack of novelty. The question thus presented was one of fact. On this question appellants had the burden of proof.” (Citing many cases.)

The Ninth Circuit decision affirming the *Hydraulic Press* case immediately above is given in p. 10a, appendix

See also *Hoeltke v. C. M. Kemp Mfg. Co.*, 80 F. (2) 912, 919 (C. C. A. 4) (appendix, p. 9a, for decision excerpt).

The fact that the defendants have not shown the Examiner to be in error (their catalog of elements set forth on pages 44 to 47 of their brief was shown to be wrong), their failure to find in Miller the problem of getting rid of the moisture condensate, the admission by defendants' expert Langville that Miller did not solve the condensate problem (Tr. 205), all lead to the one conclusion—that defendants have not sustained their burden under the law. *Dean Rubber Mfg. Co. et al. v. Killian, supra* (appendix p. 13a).

D. The Birch et al. Patent Which Appellants Attempt to Combine With Miller (Bottom of Page 45 of Their Brief) Like Miller, Does Not Consider the Problem of the Elimination of Moisture Condensate on the Interior of the Shingle—Birch Cannot Anticipate.

(1) The Birch patent was withdrawn by the defendants at the pre-trial conference (Tr. 35) and is not strictly involved in the appeal.

The fact that the Birch patent was originally set up in defendants' answer and counterclaim and then deliberately withdrawn at the Pre-trial conference leaves no alternative for the Court other than to assume that defendants admit that Birch is not a proper reference. Moreover, defendants offered not the slightest testimony in regard to Birch so that plaintiffs had no opportunity to cross-examine any of their witnesses as to the contents of this patent. It is therefore entirely improper for appellants to rely in any manner on Birch for the first time in this appeal.

- (2) However, without relinquishing the point that Birch has been disclaimed by defendants as a reference and is not part of this appeal, perhaps out of an abundance of caution, appellee wishes to point out that even if Birch were part of the Record, it still would not anticipate the Korter claim considered either separately or in combination with Miller.

As in the case of Miller, Birch lacks many features of the Korter combination. Actually it has only *one* of Korter's ten claimed features and that is, it does show in Fig. 14 the use of corrugations 22a projecting downwardly from the shingle. But these corrugations are not for the purpose of Korter's corrugations, nor do they have the function of Korter's corrugations, as will be pointed out hereinafter.

We fail to find in Birch "an aluminum shingle"—the patentee mentions no particular metal; Birch lacks the reversely turned curved lateral edge portions because the tongue 31 (Fig. 6 of patent) is intended to fit into a groove into the side adjacent shingle—there is no clasping effect; it has no "S" form of joint at the longitudinal edges; it lacks the recited "gutter" formed of "half round" longitudinal edge portions; it has no "fastening tab integral with the shingle"; no "drain slot" of any kind is mentioned; and, finally, Birch mentions no possibility that if the corrugations were placed on the interior of the shingle they would necessarily serve to space the shingle from the upper surface of the joint of the lower adjacent shingle.

- (3) There is no identity of disclosure between the Miller and Birch patents as would justify combining them—the purposes of the patents are entirely different.

In their desperate efforts to use Miller as a basic reference, and noting that Miller lacks at least the corrugations on the inner surface of the shingle, appellants strive to pick this single isolated feature from Birch (Fig. 14). This

cannot be done unless they can show that the Miller and Birch disclosures are sufficiently germane as to encourage a legitimate substitution or addition. *Lombard et al. v. Coe*, 33 F. Supp. 440, 441 (District Court, District of Columbia) (see appendix p. 12a for excerpt of decision); *Bates v. Coe*, 90 U. S. 31, 25 L. Ed. 68.

Again, in *Ex parte McCollum*, 204 O. G. 1346, 1347, Assistant Commissioner Newton ruled:

“In determining the patentability of a claim over features found only in a plurality of references it is necessary to consider the structural differences specified in the claims, as well as their functional difference or result. If the structures of the several references cannot be combined without the exercise of invention, even though the result is old, the claim should be allowed. If the structures of the references may be combined or substituted one for the other and the combined function or result is new, the claim should be allowed. It is only when both the structural features found in the references may be combined without invention to meet the structure called for by the claim and the function or result involves no invention that the claim should be rejected.”

N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co., 25 F. (2) 359, 663 (C. C. A. 6) (see appendix p. 8a for excerpt).

Miller's shingle is a double width affair with entirely different forms of longitudinal and lateral locking joints than Birch and the patents are not directed to the same purpose, nor do they have similar structures.

The law as to combining references was well stated by the Patent Office Board of Appeals in *Ex parte Frank E. Ward*, 35 USPQ 538, 539; *Imhaeuser v. Buerk*, 101 U. S. 647, 660 (see appendix p. 12a).

- (4) Appellants' argument (page 48 of their brief) as to why Miller and Birch should be combined, how to combine, and what would be the result of combining, is both incomplete and not convincing.

Appellants state (bottom of page 47 of their brief) that "Corrugations on the inner face as taught by Birch et al., Fig. 14, provide spacing identically as called for." They made this statement in a last minute attempt to cover up at least one deficiency that they found in the Miller catalog of elements set forth on page 45 of their brief. But before they can pick a desirable element out of thin air or from Birch, they must show what basis there is in Miller to make the substitution, and if the substitution were made, that it would anticipate Korter's claim both in structure and in function. This they cannot do because neither patent mentions or suggests the feature of eliminating the moisture condensate.

Ex Parte Frank E. Ward, supra:

"The patents neither disclose the difficulty nor teach how it is overcome. The combination recited in the claims is clearly new, as far as the art cited is concerned. If the Patents were to be combined as indicated in the rejection no one would know whether the result desired by the applicant would be obtained. The disclosure of the present application is the only one before us that teaches this."

Moreover, if Miller's corrugations 6^c, b¹, b⁵ and c¹ were extended below the shingle, as suggested by Birch, Fig. 14, Miller's corrugation would still not serve to space the inner surface of the shingle from the upper surface of the joint of the lower adjacent shingle because the corrugations would still be *too short*. The corrugations must cover the joint, as shown and claimed by Korter before the spacing feature can be obtained. If the substitution

were made, notwithstanding the absence of any basis for it, there would still be lacking in Miller the use of a "gutter" because in Miller no water reaches the horizontal joint from within or without (as distinguished from the vertical joint, for reasons already stated) and there would still be lacking a "drain slot" because in Miller any crack or crevice would become clogged insofar as the slow-moving, small force of flow of water condensate is concerned.

It is of interest to note in Birch that the only reason for providing the corrugations 22, 22a, whether they be up or down, is set forth on page 2, column 1, of Birch, lines 12 to 20:

"and to make such a long strip resemble several shingles, the length of the strip, as measured from side to side, is broken up by a plurality of division ridges 22, which give the long strip the appearance of a plurality of shingles. These division ridges may be upstanding as in Fig. 3, or alternatively, they may be formed as depressions, such as shown at 22a in Fig. 14."

Does this sound as if a solution of the problem of getting rid of moisture condensate was forthcoming? Certainly not!

E. Slaughter Patent is Not Pertinent.

- (1) Slaughter fails to show the ten features of Korter's combination claim.

Slaughter is one of the patents that defendants have grouped together on page 48 of their brief under a broad "shotgun" statement as to what these patents allegedly show when, in fact, individually they show nothing of the kind except in defendants' own imagination. Had the six patents been discussed separately by them, their individual weaknesses as references would have been uncovered.

To mention only a few of Korter's ten claimed features not found in Slaughter; there are no corrugations forming ridges on the *inner face* of the shingle; there are no "S" horizontal locking joints using a "half round" to form a gutter; there is no fastening tab integral with the shingle, no "drain slot" (by which we mean an opening that is always open to slow moving dribblets of water); and, finally, there is no spacing between the inner surface of the shingle and the upper surface of the lower adjacent shingle through which moisture condensate can travel.

(2) Slaughter does not mention or suggest problem of getting rid of moisture condensate—the shingle could not inherently take care of the condensate.

We defy appellants to find any mention or suggestion of ridding the inner surface of Slaughter's shingle of moisture condensate. In fact, Figure 4 of the patent shows a tight joint between the interior of the shingle A and the upper portion of the flap a so that no water could possibly run in and through the joint at C. When the shingles are fitted together on the roof, any small crack or crevice at the corners (if there are any) would undoubtedly fill with dust or sand (as testified to by expert Richardson and defendant Langville), and Slaughter makes no provision to keep them open.

(3) Transcript reference to this patent.

The patent was not advanced by appellants during the trial below and they offered no testimony in regard to it. However, appellee's expert, Richardson, did discuss the patent in Tr. 246 and showed that Slaughter was deficient in so many elements of Korter's combination as not to anticipate. Richardson's testimony was not rebutted on cross examination.

(4) Description of function of Slaughter structure as given on page 48 of appellants' brief, is completely in error.

An examination of Korter's claim will show that the terminology of the claimed elements is not as broad as that set forth in appellants' brief at the place noted. Korter is *not* claiming a mere "metal shingle" but one made of *aluminum*. He is *not* claiming "reversely turned opposite edges adapted to lock into adjacent shingles." Instead he is claiming, "each of said top and bottom turned edge portions comprising a half round portion" so as to form a "gutter." He is *not* claiming "open corners"—instead he is claiming a "drain slot" which means (according to Richardson and the usual dictionary meaning) that water of small velocity and small rate of flow can always pass through—it will never clog.

Appellants' recitation of what the group of the patents show is significant in that it fails to ascribe to any of the patents, including Slaughter, Korter's "corrugations forming ridges on the inner face of the shingle," Korter's gutter for receiving moisture condensate, Korter's drain slot in the gutter for getting rid of the condensate, Korter's spacing brought about by the inverted corrugations between the inner face of the shingle and the reversely turned top edge portion of the lower adjacent shingle "so that moisture can travel along the inner face of the shingle into said gutter" (last three lines of Korter claim). None of the six patents in appellants' group have the structure and function mentioned immediately above.

F. Cusack Patent Utterly Irrelevant.

- (1) All the features covered by Korter's combination claim are lacking in the patent.

To mention only a few of the elements of Korter's claim which Cusack does not have: (1) A shingle of rectangular shape (Cusack's shingle is laid diagonally); (2) Ridges on the inner face of the shingles (Cusack has no corrugations of any kind); (3) The top and bottom turned edge portions comprising a half round so as to constitute an "S" lock (Cusack has a "built-up" edge as shown in Fig. 5); (4) Cusack has no gutter anywhere due to the solid construction of his diagonal edges; (5) No drain slot in the gutter; (6) No spacing between the inner surface of the shingle and top surface of the horizontal joint of the adjacent lower shingle.

- (2) Diamond shaped shingle—not laid rectangular—no spacing between wooden sheathing and shingle—no moisture condensate problem to solve.

The shingles are laid as a "diamond" and have no upper and lower edges—only diagonal edges. Apparently the shingle is nailed, for the most part, *flat* on the roof sheathing so that there is no space over the entire inner surface of the shingle and the roof, and no moisture condensate problem to be solved.

- (3) Appellants' description of this patent given on page 48 of their brief completely in error and misleading—not in accord with the record on appeal.

This patent is completely foreign to Korter's combination claim for all the reasons set forth in connection with the Slaughter patent. Appellants' description on page 48 of their brief is meaningless in its broad terminology as to what Cusack shows and their description amounts to an admission on their part that practically no

specific element of the Korter claim can be found in the patent. Certainly, Korter's problem of ridding the inner surface of a shingle of moisture condensate is lacking, so that no structure in Cusack can offer a solution to this problem.

As in the case of all the patents mentioned in the group on page 48, none of them except Crawford was discussed by the defendants, even though the burden to prove invalidity of Korter's claim rested heavily upon them. However, appellee's expert, Richardson, did discuss Cusack on pages 247 and 248 of the record and that witness could find nothing in Cusack to anticipate Korter. Richardson's testimony was not rebutted.

G. Crawford Does Not Anticipate and Was Discredited Even by Defendants.

- (1) "All the folded edges fastened together are hammered down so as to be substantially flat and perfectly water-proof" (Col. 2, line 98)—lacks all the features of Korter's combination claim.

How can a shingle in its finished form (when laid on a roof) and "hammered down so as to be substantially flat" disclose Korter's "each of said top and bottom turned edge portions comprising a half round portion," or disclose "the turned bottom portion forming a gutter," or a "drain slot * * * for draining water," or provide a space between the inner face of the shingle and the top edge portion of the lower adjacent shingle?

- (2) No mention or suggestion of moisture condensate problem which Korter solved—Crawford shingle presents no way of getting rid of the moisture.

The sole purpose of the Crawford patent, as expressed at page 1, lines 14 and 100, is to have a "substantially flat and perfectly water-proof" shingle. Crawford was con-

cerned solely with the rain water going through the joints and not as to how moisture which originates on the *inside* surface of the shingle can get out.

- (3) Record below shows that demonstration of Crawford shingle put on by defendants was not in accordance with Crawford disclosure.

Appellants put on a demonstration in the trial court with shingles which they said were made according to the Crawford patent, in an attempt to show that moisture on the inner surface of the shingle would run down into a gutter and out through corner openings. But witness Richardson, Tr. 249, 250, showed where appellants used only a *partially made* Crawford shingle and, therefore, *not* in accordance with the teachings of the Crawford patent.

- (4) Description of Crawford shingle given in appellants' brief on page 48 is incorrect.

Appellants have conveniently forgotten to tell the Court in that excerpt that Crawford's shingle in its finished form is hammered flat so that it can have none of the features they attribute to it. Even before it is hammered down, it could not have an "open corner" as alleged by appellants, because the folded corners A⁷, A⁸ are provided for the express purpose of closing all open corners (page 1, line 97). And where do appellants find Korter's inverted corrugations, or the spacing function, in Crawford?

- (5) Defendants have discredited the Crawford patent—
hence cannot anticipate.

Defendant Langville, appearing on his own behalf said (Rec. 171):

"A. I believe I am going to disagree with Frederick Crawford. It would not be practical to try to hammer a roof down, every joint, because you couldn't

make it perfectly waterproof unless you do solder the joints.”

While such statement indicates honesty of mind, it certainly does not help to establish the pertinency of Crawford. Langville could only justify Crawford as a reference solely on the springiness of the metal. He said (Rec. 168):

“I don’t believe you can take three pieces of metal * * * and squeeze them together without a certain amount of spring coming out.”

This is further discredit of Crawford who says that his shingle is “hammered flat.” A patent on which defendants themselves cannot rely definitely cannot serve as an anticipation of Korter’s invention.

H. Lewando Patents.

(1) **Diamond shaped shingle—not laid rectangularly—lacks all the elements of Korter’s combination claim.**

These shingles are not of a “rectangular shape” when laid on the roof. Consequently, they do not have “the top” and “bottom edge” portions reversely turned because there is no top or bottom edge—only diagonal edges. Lewando cannot have “half round” edge portions forming a “gutter,” or a drain opening in the gutter, because all of the joints are “carefully filled with cement” (patent No. 124,963, Col. 2, line 15; patent No. 140,928, Col. 2, line 13).

(2) **No mention of Korter’s problem of eliminating water condensate, could not get rid of water as all joints “filled with cement.”**

The general purpose of Lewando, like Crawford, was to have a waterproof shingle and thus prevent rain from going through the joints. He makes certain of this by applying “an elastic waterproof cement” to the joints.

Lewando, like Crawford, was not concerned with water that originates on the inner surface of the shingle. The problem of moisture condensate is not mentioned in the patents, and, therefore, no solution offered. The Lewando shingle is intended to lie flat on the roof. There is no intended space between the shingle and the roof and no space for moisture of condensation to collect.

(3) Appellants' description given on page 48 completely in error and misleading.

Appellee would like to ask appellants what happens to the alleged "open corners through which any water that got under the shingle would naturally drain" (as alleged by appellants) when these corners and all joints are filled with cement? Also, how would the water drain when there is no space between the shingle and the roof sheathing, and where are Korter's inverted ridges and their function shown in Lewando?

(4) Transcript record below shows that neither of the Lewando patents can anticipate.

Notwithstanding the fact that defendants have included Lewando in the Pre-trial Order, they took no testimony regarding these patents. Even their own expert Langville, declined to discuss Lewando. Plaintiff was therefore handicapped in bringing out the fallacies of defendants' position through their own witnesses.

However, plaintiff took testimony through their own expert, Richardson, Tr. 243, 244:

"Now in the Lewando patent old art is shown of laying a shingle flat on a roof and sealing the adjacent shingles together so that the shingles after installation become a continuous hermetically sealed metal sheath over the entire roof, thus allowing no air circulation under the roof, and thus not creating the problem of water condensation."

I. Clawson Patent.

(1) No evidence was offered by defendants in the Court below as to this patent—therefore cannot be seriously viewed from anticipation standpoint.

This is still another case of defendants having advanced a patent through the Pre-trial Order, and then declining to go to the trouble of taking testimony on the patent. Or were they afraid of having the lack of anticipation exposed on cross examination?

(2) Lacks at least one-half of the ten features in Korter's patented combination.

Plaintiffs had their expert, Richardson, discuss this patent (Tr. 250, 251). He found that there was missing in Clawson:

(1) Korter's inverted corrugations and their function.

(2) No turned bottom portion.

(3) No mention of condensation of water or its elimination.

(4) It was not a rectangular shingle as defined by the Korter patent.

In addition, we wish to point out that Clawson does not have an "S" joint at the "lower" edge forming a gutter, and no drain slot is mentioned in the patent.

(3) Shows a diamond-shaped shingle—not laid rectangularly—not concerned with Korter's problem of eliminating moisture condensate along a horizontal gutter.

There is nothing in Clawson to indicate that when the shingles are pulled tight on a roof, any space between flanges 10, 11 would not become completely tight and sealed. Appellants cannot assume that there is such a space left and cannot assume that any such opening would remain open and would not become clogged with sand or

dust. In other words, appellants cannot assume that Clawson discloses a "drain opening" or "drain slot" in the absence of a statement to this effect in Clawson. In any case, Clawson makes no mention of moisture condensate or how to get rid of it so that Korter's solution of the problem is not to be found in the patent.

(4) Description given in appellants' brief on page 48 is in error and not supported by any evidence.

It is significant that appellants have not pointed to any particular part of the disclosure of any of the patents mentioned in the group that supports what they say is contained in the group of patents or any specific patent. All that they do is to refer broadly to all of the patents as a group and then to give to this group as a whole certain structure which, in their own imagination, is said to be contained in the group. Why did not appellants pinpoint the structure in any one of the patents? The answer is obvious—they could not. Even if they could, the terminology used when referring to the group of patents is so broad and entirely out of keeping with Korter's specific elements of his combination that the broad reference to the structure of these patents would be of no avail from the anticipatory standpoint.

It has already been pointed out that Clawson makes no mention or suggestion of "open corners through which any water that got under a shingle would naturally drain" because Clawson mentioned no such opening and the very nature of his shingle would be such that no water could get under the shingle. He shows no gutter and no opening in the gutter that is forever open to convey any interior water away.

Appellants' statement on page 48 is both too broad and definitely misleading as far as reference to the alleged structures contained in the various patents is concerned.

J. British Patent de Sincay.

- 1) Diamond shaped tile—not laid rectangularly—patent lacks many of the ten features of the Korter claim.

This is another patent advanced by defendants in the Pre-trial Order, and they then refused to discuss the alleged anticipation of the patent by their witnesses.

The shingles are laid diagonally, not horizontally as claimed in Korter. Plaintiff's expert witness explained Tr. 263:

“* * * and the very wording of the claim (Korter) together, of course, with the plain specification and drawing shows that they must be rectangular shingles laid with the bottom and top edges horizontal.”

de Sincay has nothing whatever to do with the moisture condensate problem which Korter solved. The patent is concerned only with *rain-water* driven in under the shingles during wind storms and in which water is relieved at openings K, but the rain-water cannot be driven upwardly over the entire length and width of the inner-surface of the shingle, and in any case of the alternate shingle which lays flat against the roof. However, in Korter's case, the moisture condensate is formed over the entire inner surface of each shingle, in *sunshine* weather as well as in *rainy* weather—dependent solely upon temperature changes between the outer and inner surfaces of the shingle, thus showing the complete and utter difference between the problems found in Korter and de Sincay.

The main object of de Sincay's invention is expressed on page 2, lines 17 and 18:

“* * * The tiles of my invention are further designed with a view to prevent the admission of wet or moisture.”

This means that he did not wish rain water to be driven over the inner-surface of the shingle from the out-

side. But in Korter the problem is how to get rid of moisture that does not come from rainy weather but instead comes from the condensation of moisture that originates on the inner-surface of the shingle, quite a different matter.

De Sincay shows no horizontal gutter as claimed and since the tile as laid is diagonal, there is no drain opening in the gutter for receiving moisture condensate as distinguished from driven in rain water. de Sincay does not disclose inverted corrugations for spacing the inner-side of the shingle from the top surface of the lower joint. de Sincay discloses neither Korter's problem nor the structure by which the problem could be solved, it follows that the patent is not a good reference.

- (2) Not concerned with a moisture condensate removal along a horizontal gutter—record below shows that one-half of the shingles lay perfectly flat on the roof so that no drainage of moisture can take place.

Every alternate tile of de Sincay is laid flat on the roof sheathing as seen in Figure 4 while the adjacent tile is parallelly spaced from the roof as shown in Figure 5. Obviously, as to the tile right flat on the roof there is no interior space in which moisture condensate could form and run into the diagonal spouts.

- (3) Description given in appellants' brief, top of page 48, as to alleged flow of moisture condensate is in error and not in accord with the patent disclosure or record below.

Appellants state:

"That any water on the underside of de Sincay's shingle such, for instance, as water condensate would run down through the shingle to the opening K."

But appellees would like to inquire of appellants as to how rain water from without (this is the only kind of water mentioned by de Sincay) could get under the shingle

shown in figure 4 which is nailed flat to the roof. There would be no space for the water to flow—appellants' theory is ridiculous. Appellants have admitted their weakness in de Sincay as a reference when they used the phrase "for instance, as water condensate," showing they supplied the reference to "condensation" out of their own imagination.

None of the patents discussed above mention the primary problem which Korter solved by his claimed combination, the elimination of water condensate which collects on the inner surface of the shingle in good weather as well as bad weather so that no solution of the problem was offered by the prior art except by Korter's own disclosure. This problem and its solution is exceedingly important to metal roofers (Richardson Tr. 83 and Wetle Tr. 221). As submitted, Korter's combination as set forth in the ten features enumerated on page 30 and cooperating together to provide a solution to the problem, represent a distinct step forward in the shingle art. *Alliance Securities Co. v. J. A. Mohr & Son*, 14 F. (2) 793, 796 (N. D. Calif., S. D.) which was affirmed by the Ninth Circuit Court of Appeals in 14 F. (2) 799 with a thorough discussion and list of authorities:

"The plaintiff has disclosed to the world a device which by its use the defendants acknowledge to be useful. The experts of the Patent Office, after the most careful consideration, have pronounced it new. Under these conditions, the law properly requires that all doubts as to the correctness of their action be removed before it will permit a court to say that a patentee has not an exclusive right to his own disclosure."

In summing up defendants' alleged case of anticipation, we submit that none of the ten patents on which they rely, either mentions or suggests the problem of moisture condensate which inevitably forms on the inner surface of

a metal shingle that is spaced from the sheathing, or the problem of how to get rid of such moisture in a practical manner, as by allowing it to drain down the shingle through the joint into a gutter, and thence out through a drain slot onto the weather side of the lower adjacent shingle. Korter's claimed combination covers the solution to this vexing problem and sets forth structure by which the problem was solved. Appellants cannot find this structure in the prior art as a combination of elements because Korter's problem is lacking.

Korter has therefore made a wide advance in the aluminum shingle art which the patent granted by the Patent Office experts acknowledges.

VI. BERGMAN IS PERSONALLY LIABLE FOR INFRINGEMENT.

The Court below made the following findings of Fact (Tr. 48):

“V

Defendant Harry X. Bergman is the *president* of Perma-Lox Aluminum Shingle Corporation, its *principal stockholder* and the *General Manager*, and *launched and organized the business* of manufacturing and selling aluminum shingles (the accused structure) and *had charge of the design of the said shingles* that were manufactured by defendant Langville and sold by defendant Perma-Lox Aluminum Shingle Corporation.

VI

Harry X. *Bergman* and Perma-Lox Aluminum Shingle Corporation *sold* the accused structure and defendant Langville manufactured it for defendant, Perma-Lox Aluminum Shingle Corporation, from July 1952, to at least the date on which the trial was commenced on March 25, 1954, and thereby infringed upon plaintiff's patent.”

These findings of fact are fully supported by the record. The answer alleges affirmatively:

“that *he* (Bergman) *does sell under the name of Perma-Lox Aluminum Shingle Corporation* (hereinafter sometimes referred to as Perma-Lox), aluminum shingles for the roofing of houses, that *he* did cause to have printed and distributed an advertisement which stated, ‘Do not confuse Perma-Lox Aluminum shingles with imitations or other aluminum products of similar name. * * *’ (Tr. 10.)

(The shingles sold, as aforesaid, are the ones which the Court determined to be infringements on plaintiff’s patent.)

In *Martin v. Be-Ge Mfg. Co. et al.*, 109 U. S. P. Q. 240, 241-242 (C. C. A. 9—decided April 19, 1956), the Court held:

“The issue of patent infringement is one of fact (*Stilz v. United States*, 269 U. S. 144, 147; *McRoskey v. Braun Mattress Co.*, 107 F. (2) 143, 147, 43 U. S. P. Q. 318, 321 (C. C. A. 9). This Court may not upset a finding of fact of the District Court “unless clearly erroneous” (Fed. R. Civ. P., Rule 52, 28 U. S. C. A.; *Graver Tank & Mfg. Co. v. Linde Air Products*, 339 U. S. 605, 609, 610 * * *.” (Many authorities cited.)

In the deposition of defendant Bergman (PX 4), he testified that he was the president of Perma-Lox Aluminum Shingle Corporation; that the stock of the corporation was all held by himself and members of his *family* (PX 4, pp. 3 & 4):

Bergman	30%
Bergman’s wife	30%
Bergman’s daughter	15%
Bergman’s son-in-law	15%
Bergman’s niece	5%
Bergman’s nephew	5%
Total	<hr/> 100%

In 1950 Bergman had an aluminum shingle roof installed on his house by the plaintiff corporation (PX 4, p. 5). He personally discussed the shingles (prices, etc.) with Korter and examined the shingles (PX 4, pp. 5 & 6). He, therefore, knew that he (Bergman) was not the inventor of the shingle. In fact, prior to that time, Bergman knew nothing about shingles as he was in the ready-to-wear dress and hotel business (Tr. 227). Bergman commenced the business of selling the accused aluminum shingle roofs in the spring of 1952 (PX 4, p. 4 and Tr. 227).

Bergman organized the defendant corporation in July 1952 under the name of AMERICAN ALUMINUM SALES CORPORATION which was later changed to PERMA-LOX SHINGLE CORPORATION (PX 4, p. 6).

Bergman supervised the advertising material (PX 4, p. 32). Bergman personally did all of the negotiation work with Langville (PX 4, p. 9) and his predecessors in regard to the manufacture of the shingles.

Upon the trial of the action, he testified that he was president of the corporation.

“Q. How did you launch yourself in this business?

A. Well, I happened to know a lot of men in the business, and I was approached—one man who approached me was a Mr. Polsky, * * *” (Tr. 228.)

On cross-examination, Bergman testified:

“Q. Mr. Bergman, aren't you the *General Manager* of the Perma-Lox Corporation?

A. Yes, sir.

Q. And, in general, *you have charge of the design of any shingles that your corporation puts out?*

A. Yes, sir.” (Tr. 233-234.)

Bergman did not merely perform the ordinary duties of an officer (president of a corporation). The record

establishes that he individually launched the business of manufacturing and selling the aluminum shingles which were held to be infringements; that he organized the *family corporation* for the purpose of carrying on the business of manufacturing and selling the accused shingle; that he is the active head of the corporation; that he is the general manager of the corporation; that he had charge of the design of the shingles marketed by the corporation; that he personally sold the infringing shingles and that the corporation is the medium by which he carried on the business of marketing the infringing shingle.

In *this Circuit*, the law relating to the personal liability of an officer of the corporation for infringement, is well settled.

In *Moseley v. United States Appliance Corporation*, 155 F. 2d 25 (C. C. A. 9), the Court held:

“On October 22, 1936, *Keele and Moseley formed Keelmo Company, a California corporation. Keelmo Company was dominated and controlled by Keele and Moseley. They owned all its stock. They and their attorney were its directors. Moseley was its president, Keele its vice president.*

* * * * *

The act of licensing Rilling-Arno Company to manufacture and sell the infringing device was itself an act of infringement. In that act, all the appellants—*Keele, Moseley and Keelmo Company*—participated; for, though not named as parties to the license agreement, *Keele and Moseley* caused the agreement to be made. *Keele*, acting for himself and *Moseley*, commenced the negotiations which resulted in the agreement. *Keele and Moseley formed Keelmo Company* for the purpose of dealing with Rilling-Arno Company. They *dominated and controlled Keelmo Company*, were its officers, directors and only stockholders, made it their agent and instrument, used

it to infringe appellee's patent, and profited by such use. Hence Keele and Moseley, as well as Keelmo Company, were liable as infringers."

In *Dean Rubber Mfg. Co. v. Killian*, 106 F. 2d 316 (8th Cir.), the Court held:

"The record shows that Wilbur J. Dean was the *active, directing head* of the defendant company and *was in charge of the operations* of the plant and gave the orders for its operation; that he was a large *stock holder* and *president* of the defendant company; that he is the owner of the accused patent, and that the *infringing machine* was *built and operated under his personal supervision*. In our opinion these facts justify the findings of the court under the following well recognized statement of the rule: 'We are of opinion, therefore, that by the general principles of law, and by analogy with other torts, a director of a corporation, who, as director, by vote or otherwise, specifically commands the subordinate agents of the corporation to engage in the manufacture and sale of an infringing article, is liable individually in an action at law for damages brought by the owner of the patent so infringed.'

In *Southwestern Tool Co. v. Hughes Tool Co.*, 98 F. 2d 42 (10th Cir.), the Court held:

"The testimony and the inferences reasonably to be drawn from it point to the conclusion that during the period in question Dufek *dominated the corporation*; that he *wilfully and knowingly participated in the acts of infringement*; and that he *used the corporation as an instrument to carry out his own deliberate infringement*. He is, therefore, *jointly liable with the corporation* for the damages resulting from the wrongful acts." (Citing many cases.)

In *Adventures in Good Eating v. Best Places to Eat*, 131 F. 2d 809 (7th Cir.), the Court held:

“It is clear that the defendant corporation was Barrett and that Barrett was the defendant corporation. * * * *He controlled, directed, and participated in the infringement.* I conclude that Carl A. Barrett is liable for infringement.’

The District Court’s acceptance of this finding must be accepted by us, for substantial evidence supports it.

The rule announced by this Court, in *Dangler v. Imperial Machine Co.*, 11 F. 2d 945, 947, we adhere to. There, we said

‘It is when the officer acts willfully and knowingly—that is, when he personally participates in the manufacture or sale of the infringing article (acts other than as an officer), or *when he uses the corporation as an instrument to carry out his own willful and deliberate infringements*, or when he knowingly uses an irresponsible corporation with the purpose of avoiding personal liability—that *officers are held jointly with the company*. The foregoing are by no means cited as the only instances when the officers may be held liable, but they are sufficient for the present case.’”

In *Marks v. Polaroid Corporation*, 129 F. Supp. 243 (U. S. Dist. Ct., D. Mass.), the Court held:

“I am convinced that Marks *participated* sufficiently *with the corporation* in the infringement of the defendant’s patents to hold him personally liable for such infringement. As the evidence shows, Marks was president of Depix from its inception until a day before it discontinued the manufacture of polarizers. *Depix was a small family corporation organized by Marks and his brother.* The latter two together with their mother were the only officers in the corporation and the three owned all its stock through ownership of another corporation which in turn held the stock of Depix. Marks supervised and directed the build-

ing of machines and equipment used by Depix in manufacturing its commercial product. * * *

These facts and others show that Marks participated actively in the business of the corporation and that *but for his direct contributions, the infringement complained of here would never have resulted.* Accordingly, I find this plaintiff a guiding spirit behind the infringement and hold him personally liable with the corporation for its occurrence." (Citing numerous cases.)

General Motors Corporation v. Provus, 100 F. (2) 562 (C. C. A. 7) (appendix p. 13a); *Gere v. Canal Boiler Works*, 33 F. Supp. 558 (D. C., W. D. Wash. N. D.) (appendix p. 14a).

In *Electrical Products Corporation v. Neale*, 48 F. 2d 824 (D. Ct., S. D. Cal., Central Div.), the Court held:

"The defendants Edward G. Neale and Thomas N. Neale are individually *liable* for the acts of Neale, Inc., *by reason of their control and direction of the corporation's business and their ownership of practically all of the capital stock of the corporation.*"

In *Claude Neon Lights, Inc. v. American Neon Light Corporation*, 39 F. 2d 548 (2nd Cir.), the Court held:

"The directors of the American Neon Light Corporation were properly enjoined from continuing the infringement. This corporation was organized after the introduction of the invention into this country and after it had attained considerable commercial success. The corporation was organized to enter the neon sign business. There was litigation pending in the various courts of the United States for infringement of this patent. *The directors were more than merely organizing a corporation; they specifically depended upon the manufacture and sale of neon luminescent tubes which reasonable men would have known were an infringement of the patent in suit.*

* * * *All persons who participate in the infringement are liable, although some are simply acting as officers of the corporation.* * * * National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co. (C. C.) 19 F. 514. * * * They become liable when they do exceed their authority and use the corporation to carry out their own willful and deliberate infringement. Dangler v. Imperial Machine Co. (C. C. A.) 11 F. (2d) 945."

See also Patents, 69 C. J. S., 918, Sec. 315—appendix, p. 14a.

In *Krieger v. Colby*, 106 F. Supp. 124 (Cal.), the Court held:

"The person who infringes a patent is committing a tort, 69 C. J. S., Patents, § 42; Lincoln Engineering Co. of Illinois v. Stewart-Warner Co., 7 Cir., 91 F. 2d 757, and Metallizing Engineering Co. v. Metallizing Co. of America, D. C., 62 F. Supp. 274, and from the evidence adduced herein it seems to this Court that *Colby is a joint Tort-feasor.*"

Infringement is a tort and the rule of liability applies in patent cases the same as it does in all tort cases that the individual who actively commits the tort is jointly liable with the corporation, whether he be an officer, director, stockholder or employee.

And so, one who launches upon a program of pirating an invention and organizes a corporation to carry on the business of infringing and actively designs the infringing device, manages the corporation in the manufacture and sale of the device, is clearly a joint tortfeasor.

We believe that this Court will wish to discourage persons who are put into a position, such as Bergman, to know all of the inventive features of a shingle put out by a bonafide shingle manufacturer (Korter) and who then, having no present knowledge of the shingle business except that which was gained by an inspection of the pur-

chased shingle, starts up a corporation, and completely controls the same for the express purpose of manufacturing and selling shingles of the same character as that which had been supplied to him on a bonafide sale by the reputable shingle manufacturer. It follows that Bergman, as well as his corporation, are singly and jointly liable for the infringement.

A. Defendants' Cases Distinguished.

The case of *Powder Power Tool Corporation v. Powder Actuated Tool Company*, 230 F. 2d 409 (7th Cir.), is not at all in point. In that case, the individual sought to be held liable did not individually engage in any act of infringement. The infringing device was "designed" by another person. The corporation, which was found guilty of infringement, was organized long prior to the granting of the patent which was infringed. Upon this significant fact, the Court said:

"When defendant company was organized there was no patent in existence, and defendants had no knowledge that a patent might issue, hence the company could not have been organized to carry on a wilful and deliberate infringement."

In the case at bar, the facts are diametrically opposed. Here, defendant Bergman launched upon the pirating of Korter's invention prior to the formation of his corporation. He formed the corporation for the very purpose of engaging in the business of manufacturing and selling the infringing shingles. The *family corporation* engaged entirely in the manufacturing and sale of the infringing shingle.

The Court did not in the slightest degree recede from the rule which it recognized in the *Dangler* case (11 F.

2d 945) that an officer of a corporation is jointly liable with the corporation where he forms a corporation for the purpose of engaging in the infringement and personally participates therein.

In the case of *Tinsel Corporation v. B. Haupt & Co.*, 25 F. 2d 318, cited by appellant, it was sought to hold officers of the corporation liable merely because they were officers and *not by reason of any personal participation* in the commission of the infringement as in the case at bar.

In *Dangler v. Imperial Machine Co.*, 11 F. 2d 945 (7th Cir.), cited by appellant, it was sought to hold officers liable merely because they were officers of the corporation and *not by reason of personal active participation in the infringement* or in the creation of the corporation that was to engage in the infringement. The Court recognized that under conditions such as in the case at bar, officers of a corporation must be held liable as joint tortfeasors. See quotation in *Adventures* case, *supra*.

In *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 Fed. 236 (6th Cir.), cited by appellant, the Court held that an officer is not liable

“unless the officer inflicted the damages.”

The facts as to the relationship of the officer to the corporation and the extent to which he participated in the infringement are not set forth and it is apparent that there was no evidence of such participation as would make the officer a joint tortfeasor.

VII. CONCLUSION.

1. The Korter patent 2,631,552 is infringed by the accused shingle. (PX-3.)

2. Each of the defendants are severally and jointly liable in damages for such infringement including personal liability of Harry X. Bergman.

3. The Korter patent is valid.

4. The holding of the trial court as to infringement, the liability of each of the defendants, severally and jointly, and validity of the Korter patent should be sustained.

5. The findings of fact, conclusions of law and Decree of the Court below (Tr. 46 to 56) should be affirmed.

Respectfully submitted,

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APPENDIX.

APPENDIX OF DECISIONS.

Specialty Equipment & Machinery Corp. v. Zell Motor Car Co., 193 F. (2) 515-519 (C. C. A. 4), the Court held:

“In the case of *Crown Cork & Seal Co. v. Aluminum Stopper Co.*, 4 Cir., 108 F. 845, 866, this court, speaking through Judge Brawley, said: ‘Infringement is not avoided by mere change of form, or renewals of parts, or reductions of dimensions, or the substitution of mechanical equivalents, or the studious avoidance of the literal definition of specifications and claims, or the superadding of some improvement. The court will look through the disguises, however ingenious, to see whether the inventive idea of the original patentee has been appropriated, and whether the defendants’ device contains the material features of the patent in suit, and will declare infringement even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement.’ See also *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 41-42, 50 S. Ct. 9, 74 L. Ed. 147; *Frick Co. v. Lindsay*, 4 Cir., 27 F. 2d 59, 62; *Hartford Empire Co. v. Swindell Bros.*, 4 Cir., 96 F. 2d 227, 231.”

In *United States Rubber Co. v. General Tire & Rubber Co.*, 128 F. (2) 104, 108, 109, the Circuit Court of Appeals, Sixth Circuit, speaking through Circuit Judge Martin, said:

“Appellant correctly asserts that even where the invention must be restricted in view of the prior art to the form shown and described by the patentee without extension to embrace a new form constituting a substantial departure, *there is infringement where the departure is merely colorable.* *E. H. Bardes Range & Foundry Company v. American Engineering Company*, 6 Cir., 109 F. 2d 696, 698; *Duff v. Sterling Pump Company*, 107 U. S. 636, 639, 2 S. Ct. 487, 27

L. Ed. 517; Sanitary Refrigerator Company v. Winters, 280 U. S. 30, 41, 50 S. Ct. 9, 74 L. Ed. 147. Furthermore, except where form is of the essence of the invention, one device is an infringement of another 'if it performs substantially the same function in substantially the same way to obtain the same result.' Union Paper Bag Machine Company v. Murphy, 97 U. S. 120, 125, 24 L. Ed. 935. It is also well settled that, although some change in form and position is apparent, a close copy which uses the substance of an invention, employs the same device, performing the same offices with no change in principle, constitutes infringement of the invention. Ives v. Hamilton, 92 U. S. 426, 430, 23 L. Ed. 494; E. H. Bardes Range & Foundry Company v. American Engineering Company, supra. *Infringement is not avoided by change in degree, so long as the distinguishing function is retained, or by adding elements to the complete structure of the patent claim.* Murray v. Detroit Wire Spring Company, 6 Cir., 206 F. 465, 468. Inasmuch as specifications and claims are addressed to persons skilled in the art, the claims of a patent should be construed liberally to uphold and not to destroy the rights of the inventor. National Battery Company v. Richardson Company, 6 Cir., 63 F. 2d 289, 293. In Walker on Patents (Deller's Edition), Vol. 3, Sec. 482, pages 1728, 1729, the author says:

'A combination of old elements which accomplishes a new and beneficial result, or attains an old result in a more facile, economical or efficient way, may be protected by a patent as securely as a new machine or composition of matter. * * * And the doctrine of mechanical equivalents is governed by the same rules and has the same application when the infringement of a patent for a combination is in question as when the issue is over the infringement of a patent for any other invention.' "

Sanitary Refrigerator Company v. Winters et al., 280 U. S. 30, 42, in which the Supreme Court said:

“* * * ‘Authorities concur that the substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if *two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same even though they differ in name, form, or shape.*’ *Machine Co. v. Murphy*, 97 U. S. 120, 125. And see *Elizabeth v. Pavement Co.*, 97 U. S. 126, 137. *That mere colorable departures from the patented device do not avoid infringement*, see *McCormick v. Talcott*, 20 How. 402, 405. A close copy which seeks to use the substance of the invention, and, although showing some change in form and position, uses substantially the same devices, performing precisely the same offices with no change in principle, constitutes an infringement. *Ives v. Hamilton*, 92 U. S. 426, 430. And even where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee and cannot be extended to embrace a new form which is a substantial departure therefrom, it is nevertheless infringed by a device in which there is no substantial departure from the description in the patent, but a mere colorable departure therefrom. Compare *Duff v. Sterling Pump Co.*, 107 U. S. 636, 639.”

General Motors Corporation v. Kesling, 164 F. (2) 24, 833 (C. C. A. 8):

“The parties agree that to constitute infringement the accused device must, in a patent sense, accomplish the same result and by the same means and by the same method of operation. *Sanitary Refrigerator Co. v. Winters*, 280 U. S. 30, 42, 50 S. Ct. 9, 74 L. Ed. 147; *Montgomery Ward & Company v. Clair*, 8 Cir., 123 F. 2d 878, 881; *McDonough v. Johnson-Wentworth Co.*, 8 Cir., 30 F. 2d 375, 383; *Electric Protection Co.*, 8 Cir., 184 F. 916, 923.”

35 U. S. C. A. 120 (Codification Act of 1953) provides:

“An application for patent for an invention disclosed in the manner provided by the first paragraph of Section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention as though filed on the date of the prior application if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.”

(*Westinghouse Electric & Mfg. Co. v. Condit Electrical Mfg. Co.*, 194 Fed. 427.) Judge Learned Hand adhered to the general rule as set forth in *Campbell Metal Window Corporation v. S. H. Pomeroy & Co.*, 300 Fed. 872, 874, in which he said:

“I do not understand that this case meant to require me to go through all that was said in the endless communications between applicant and Examiner to gather piecemeal the intent of the grant, as though I were construing a correspondence. If so, what is the purpose of the final formal instrument? The reference of the court to such confirmation of an otherwise clear meaning is not to be taken as establishing a general rule. In any event, it is well settled by authorities binding upon me that in this circuit we do not look to such exterior expression of intent, but treat a patent as we should a will, a deed, or any other instrument intended to be a final memorial of the parties' intention. *Westinghouse Elec. Co. v. Condit Elect. Co.* (C. C. A. 2) 194 Fed. 427, 430, 114 C. C. A. 389; *Auto Pneumatic Action Co. v. Kindley & Collins* 247 Fed. 323, 328, 159 C. C. A. 417; *Spaulding & Bros v. Wanamaker* (C. C. A. 2) 256 Fed. 530, 533, 534 167 C. C. A. 602.”

Goodwin Film & Camera Co. v. Eastman Kodak Co.
(District Court, W. D. New York), 207 Fed. 351, 357:

“The general rule is that the interpretation to be placed on a patent is to be determined by the language of the grant, and that the proceedings of the Patent Office are immaterial unless, of course, the patentee by his acquiescence has accepted limitations imposed by the rejection of broader claims. *Westinghouse Elec. & Mfg. Co. v. Condit Elec. Mfg. Co.*, 194 Fed. 427, 114 C. C. A. 389; *Beach v. American Box-Mach. Co.* (C. C.) 63 Fed. 597.”

Dean Rubber Mfg. Co. et al. v. Killian, 106 F. (2) 16, 320 (C. C. A. 8):

“While the file wrapper shows a rejection of certain of the original claims for anticipation by Hadfield, taken with Brubaker, and that the claims were amended and the patent issued upon the amended claims, a comparison of the original claims with those upon which the patent finally issued does not, in our opinion, disclose anything which would operate as a file wrapper estoppel. We find nothing in the proceedings before the examiner to indicate that the original claims were narrowed in their scope for the purpose of avoiding rejection. The language of the amended claims is, in some respects, more definite than that employed in the original claim, but reading all of the claims together, they are not essentially different than in their original forms. We find no evidence of a surrender of any substantial claim as a condition upon which the patent was issued. We cannot agree with defendants’ contention as to file wrapper estoppel.”

Baltzley et al. v. Spengler Loomis Mfg. Co. et al.,
262 Fed. 423, 426 (C. C. A. 2):

“The argument for noninfringement is sought to be strengthened by reference to the contents of the file wrapper. * * * Having from this viewpoint ex-

amined the file wrapper, we are of opinion that the patentee's disclosure stated fully and at first facts sufficient upon which to ground the claims in suit, and such claims or their equivalents he never receded from. Many claims, first propounded, were obviously too broad; but Baltzley never 'accepted limitations imposed by the rejection of broader claims' and affecting the claims in suit. The residuum is ample for the purpose of this case. See *Goodwin et al. v. Eastman, et al., Co.* (D. C.) 207 Fed. 357 affirmed 213 Fed. 231, 129 C. C. A. 575."

In *Bullock Electric Mfg. Co. et al. v. Crocker-Wheeler Co.*, 141 Fed. 101, 110 (Circuit Court, D. New Jersey), it was stated:

"Conceding for the purpose of the argument, that method claim 1 and canceled claim 3 are the same in substance and differ only in form, no authority has been referred to holding that, if one of several claims in an application for a patent be canceled while the application is pending in the patent office, a retained claim substantially the same as the canceled one is thereby annulled. * * * but, if two claims in an application for a patent should inadvertently be expressed in identical language, the withdrawal or cancellation of one of them would not affect the other."

Ex parte Collins as reported in 44 USPQ 82, 84 the Patent Office Board of Appeals said:

"* * * but until an application has matured into a patent, we know of no authority which estops one by cancellation from representing the cancelled subject matter. *Obviously, until a patent is granted, there is no dedication of any disclosed but not claimed subject matter to the public* and therefore no injury if an attempt is made to subsequently reclaim the canceled subject matter. Thus, one of the essential elements of estoppel, injury, is absent."

General Electric Corporation v. Hygrade Sylvania Corporation et al., 67 USPQ 72, 75, in which District Judge Leibell said:

“In considering these contentions, we start with the general proposition that the applicant for a patent is not barred from restoring to his patent application, *before the patent is issued*, any claim which he might theretofore have cancelled, even if the cancellation was made because of citations of the prior art. *Ex parte Collins*, 44 USPQ 82, 84.”

In the book entitled “*Patent Office Rules and Practice*” by Leon H. Amdur (who is considered a well known authority on the intricacies of Patent Office Practice), states at Sec. 199c:

“The rule of *res adjudicata* is applicable only where there has been a final decision (final rejection). In this case (*Ex parte Pierce*, 4 Gour. 43:36) the Commissioner said that an applicant should not be precluded from inserting a claim because he has previously presented and canceled a claim having the same scope, said claim not having been finally rejected.”

Ensign Carburetor Co. v. Zenith-Detroit Corporation, 36 F. 2d 684, 686 (C. C. A. 2):

“The patent in suit was granted only after a consideration of the principal prior patents which are now referred to as anticipations: Noyes, Nos. 979,788 and 993,097; British patent No. 1217, of 1905, to Peloux; Stewart patent, No. 960,601. Having had this consideration before the patent issued, the usual presumption of validity which accompanies the grant is greatly reinforced. *Smokador Mfg. Co., Inc. v. Tubular Products Co.* (C. C. A.) 31 F. (2d) 255; *Foster v. T. L. Smith Co.* (C. C. A.) 244 F. 946.”

Anraku v. General Electric Co., 80 F. 2d, 958, 960 (C. C. A. 9—Circuit Judge Haney):

“In the case last cited 67 F. (2d) 807, page 809 it is said:

‘In its brief, the appellant * * * says: “The general rule is that a patent is presumptively valid. This presumption arises from the grant of the patent by the Patent Office after the application has been examined thoroughly by the Examiner.”

“The foregoing excerpt unquestionably correctly states both the rule of law and the reason therefor.’ ”

N. O. Nelson Mfg. Co. v. F. E. Myers & Bro. Co., 23 F. 2d 659, 663 (C. C. A. 6):

“* * * And a patent otherwise valid is not void for anticipation because a prior patent covers a device which might be so constructed as to be capable of the same use as that of the later patent, where the prior art gives no suggestion that such use was contemplated and no specific directions for such construction. *Topliff v. Topliff*, 145 U. S. 156, 161, 12 S. Ct. 825, 36 L. Ed. 658; *Canda v. Michigan Co.* (C. C. A. 6), 124 F. 2d 486, 492.”

Coffin v. Ogden, 18 Wall. 120, 21 L. Ed. 821:

“The invention or discovery relied on as a defense must have been complete and capable of producing the result.”

Loom Co. v. Higgins, 105 U. S. 580, 591:

“* * * It may be laid down as a general rule though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result, never attained before, it is evidence of invention. * * *”

In *Gordon Form Lathe Co. v. Walcott Mach. Co.*, 32 F. (2) 55, 58 (Circuit Court of Appeals, Sixth Circuit) Judge Hickenlooper stated:

“Those patents cannot be considered as anticipations which do not disclose the purpose, means, and mechanism for accomplishing the end of the patent in suit, and which are restricted, by the mechanisms disclosed, to the accomplishment only of a substantially different and limited purpose. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U. S. 45, 66, 43 S. Ct. 322 (67 L. Ed. 523); *Canda et al. v. Michigan M. Iron Co.*, 124 F. 486, 493 (C. C. A. 6); *Munising Paper Co. v. American Sulphite Pulp Co.*, 228 F. 700, 703 (C. C. A. 6); *Hobbs et al. v. Beach*, 180 U. S. 383-392, 21 S. Ct. 409 (45 L. Ed. 586); *Fulton Co. v. Bishop & Babcock Co.*, 284 F. 774, 777 (C. C. A. 6).”

In *Hydraulic Press Mfg. Co. v. Ralph N. Brodie Co. et al.*, (District Court, N. D. California, S. D.) 51 F. Supp. 202, 205, 59 USPQ 268, District Judge Goodman stated:

“If by virtue of the combination, the purpose is accomplished in a manner never theretofore disclosed, it has that novelty which bespeaks for it the monopoly bestowed under the patent law. *Hoeltke v. Kemp Mfg. Co.*, 4 Cir., 80 F. 2d 912.”

The *Hoeltke* case on which Judge Goodman relied is found in 80 F. (2) 912, 919 (*Hoeltke v. C. M. Kemp Mfg. Co.*) in which Circuit Judge Parker (Circuit Court of Appeals, Fourth Circuit) said:

“We think there can be no doubt as to the patentability of complainant’s device; but if there were doubt, there can be no question but that this doubt should be resolved in favor of the validity of the patent. *The ordinary presumption of novelty arising from the grant of the patent is greatly strengthened*

because of the contest in the Patent Office. *Hildreth v. Mastoras*, 257 U. S. 27, 32, 42 S. Ct. 20, 66 L. Ed. 112; *Gairing Tool Co. v. Eclipse Interchangeable Counterbore Co.* (C. C. A. 6th) 48 F. (2d) 73; *Smokador Mfg. Co. v. Tubular Products Co.* (C. C. A. 2d) 31 F. (2d) 255; *Ensign Carburetor Co. v. Zenith-Detroit Corporation* (C. C. A. 2d) 36 F. (2d) 684, 686. *The invention filled a want in the industry and entered into immediate use when placed on the market by the defendant.* *Temco Co. v. Apco Co.*, 275 U. S. 319, 48 S. Ct. 170, 72 L. Ed. 298; *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, supra; *Pangborn Corporation v. W. W. Sly Mfg. Co.* (C. C. A. 4th) 284 F. 217. And in addition to this we have the presumption arising from the imitation of the patented article by the manufacturers of the alleged infringing device. As to this, we agree with what was said by Judge Hough, speaking for the Circuit Court of Appeals of the Second Circuit in *Kurtz v. Belle Hat Lining Co.*, 280 F. 277, 281; "The imitation of a thing patented by a defendant, who denies invention, has often been regarded, perhaps especially in this circuit, as conclusive evidence of what the defendant thinks of the patent, and persuasive of what the rest of the world ought to think." See also, *Black & Decker Mfg. Co. v. Baltimore Truck Tire Service Corp.*, supra, 40 F. (2d) 910, at page 914."

The Circuit Court of Appeals, Ninth Circuit, upheld the reasoning of Judge Goodman in the *Hydraulic Press v. Brodie* case in *Ralph N. Brodie Co. et al. v. Hydraulic Press Mfg. Co.* (C. C. A. 9) 151 F. (2) 91, 94, in which the Court said:

"Both patents were regularly issued. Hence both patents and all claims thereof were presumptively valid. (*Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 7-10, 54 S. Ct. 752,

78 L. Ed. 1453; *Reinharts v. Caterpillar Tractor Co.*, 9 Cir., 85 F. 2d 628, 630.) Hence the burden of establishing the invalidity of claims 7, 9, 10, 11, 14 and 15 of patent No. 2,067,265 and claims 7, 8, 9 and 10 of patent No. 2,136,240 rested on appellants.

“All of these claims were for combinations. Appellants alleged, in substance and effect, that these combination were not new, and that therefore the claims were invalid for lack of novelty. The question thus presented was one of fact. *On this question, appellants had the burden of proof.* (*Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 171, 57 S. Ct. 675, 81 L. Ed. 983; *Parker v. Stebler*, 9 Cir., 177 F. 210, 212; *San Francisco Cornice Co. v. Beyrle*, 9 Cir., 195 F. 516, 518; *Diamond Patent Co. v. S. E. Carr Co.*, 9 Cir., 217 F. 400, 402; *Los Angeles Lime Co. v. Nye*, 9 Cir., 270 F. 155, 163; *Schumacher v. Buttonlath Mfg. Co.*, 9 Cir., 292 F. 522, 531).

“Appellants alleged, in substance and effect, that the combinations did not involve invention, but were merely the product of ordinary skill, and that therefore the claims were invalid for lack of invention. The question thus presented was one of fact. On this question, appellants had the burden of proof. (*Hunt Bros. Fruit Packing Co. v. Cassidy*, 9 Cir., 53 F. 257, 259; *Reinharts v. Caterpillar Tractor Co.*, *supra*; *National Nut Co. v. Sontag Chain Stores Co.*, 9 Cir., 107 F. 2d, 318, 333).

“On both questions—the question of novelty and the question of invention—the evidence was conflicting. Resolving the conflicts in favor of appellee, the court found that the combinations were new, that they involved invention, and that therefore the claims were not invalid for lack of novelty or for lack of invention. These findings are supported by substantial evidence, are not clearly erroneous and should not be set aside.”

Lombard et al. v. Coe, 33 F. Supp. 440, 441, the District Court, District of Columbia:

“To justify the rejection of the claims it was necessary for the Examiner to combine a number of prior art patents. He points out that a part of the invention is found in one patent, and another part in another, and still another part in a third or fourth one, and then draws the conclusion that the applicant is not the original or first inventor. This is not proper. *Bates v. Coe*, 90 U. S. 31, 25 L. Ed. 68.”

The law as to combining references was well stated by the Patent Office Board of Appeals in *Ex parte Frank E. Ward*, 35 USPQ 538, 539:

“The patents neither disclose the difficulty nor teach how it is overcome. The combination recited in the claims is clearly new as far as the art cited is concerned. If the patents were to be combined as indicated in the rejection no one would know why they should be combined or whether the result desired by the applicant would be obtained. The disclosure of the present application is the only one before us that teaches this.”

Imhaeuser v. Buerk, 101 U. S. 647, 660:

“Where the thing patented is an entirety, consisting of a single device or combination of old elements incapable of division or separate use, *the respondent cannot escape the charge of infringement by alleging or proving that a part of the entire invention is found in one prior patent, printed publication, or machine, and another part in another prior exhibit, and still another part in a third exhibit, and from the three or any greater number of such exhibits draw the conclusion that the patentee is not the original and first inventor of the patented improvement. Bates v. Coe*, 98 U. S. 31, 48.”

In *Dean Rubber Mfg. Co. et al. v. Killian*, 106 F. (2) 316, 318, the Circuit Court of Appeals, Eighth Circuit, stated:

“It seems to be well settled that the allowance and issuance of a patent by the patent office creates a presumption as to its validity (*Mumm v. Jacob E. Decker & Sons*, 301 U. S. 168, 57 S. Ct. 675, 81 L. Ed. 983; *Radio Corporation of America v. Radio Engineering Laboratories*, 293 U. S. 1, 55 S. Ct. 928, 79 L. Ed. 163), and there can be no question but what the presumption of validity is strengthened when the particular prior art relied upon by the defendant in an infringement suit was urged before, and considered by the Patent Office, and the claims of the application were allowed over that art. *Gairing Tool Co. v. Eclipse Interchangeable Counterbore Co.*, 6 Cir., 48 F. 2d 73.”

General Motors Corporation v. Provus, 100 F. 2d 562 (C. C. A. 7):

“Taking the record as a whole, there can be no doubt that the facts tend to indicate a preconceived and deliberate conduct on the part of the officers to *use the corporation merely to carry on the infringing and unfair practices* and that these practices constituted conduct so palpable and so alien to the purpose of a bona fide corporation that from this alone it might be concluded that the conduct was willful, deliberate and personal on the part of the officials. It is impossible for this court to believe appellant’s professions of innocence and inactivity. His actions during the life of the corporation conflict with his professions of innocence and inactivity, and the inference is compelling that appellant’s part in the illicit conduct of the corporate business is very suggestive of wrongful premeditation and design.

It is our opinion that the conclusion reached by the trial court was warranted and that the proven

facts and legitimate inferences clearly show the case falls within the exception to the general rule laid down in the Dangler Case.

The decree is affirmed."

In *Gere v. Canal Boiler Works*, 33 F. Supp. 558 (D. C., W. D. Wash., N. D.), the Court held:

"As to the individual liability of the defendants Youngquist and Rogers, the evidence seems to bring them under the principle that 'every voluntary perpetrator of a wrongful act of manufacture, use or sale of a patented article becomes ipso facto an infringer, and is legally responsible; and it therefore regards officers, directors, and agents employing or authorizing or assenting to the use of the patented invention as infringers, and personally responsible to the patentee.' *Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co.*, C. C., 45 F. 582, 584; *National Car-Brake Shoe Co. v. Terre Haute Car & Mfg. Co.*, C. C., 19 F. 514; *National Cash-Register Co. v. Leland*, 1 Cir., 94 F. 502.

It is fundamental that *one cannot escape liability for tort in which he personally actually participated.* *Hitchcock v. American Plate Glass Co.*, 3 Cir., 259 F. 948."

Patents, 69 C. J. S., 918, Sec. 315, the text says:

"Moreover, in some cases an officer or agent may be personally liable with the corporation, as where he willfully, knowingly, and personally participates in the manufacture and sale of an infringing article, or uses the corporation as an instrument to carry out his own willful and deliberate infringements and for the purpose of avoiding personal liability. It has also been held that a director who, by vote or otherwise, specifically commands a subordinate to engage in the manufacture and sale of an infringing article, is individually liable, regardless of whether he knew that the article manufactured and sold infringed a patent."